

O R I G I N A L

FILED

DOCKETED

SEP 21 1979

SEP 18 1979

H. STUART CUNNINGHAM, CLERK

# STENOGRAPHIC TRANSCRIPT

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF ILLINOIS  
EASTERN DIVISION

----- X  
BALLY MANUFACTURING CO.

Plaintiff,

vs.

D. GOTTLIEB & CO.,  
WILLIAM ELECTRONICS, INC.,  
and

ROCKWELL INTERNATIONAL

Defendants.  
----- X

Civil No. 78 C 2246

Deposition of:

VANCE Y. HUM

Arlington, Virginia  
July 24, 1979

## DEO REPORTING

4860 KENMORE AVENUE  
ALEXANDRIA, VIRGINIA 22304

OFFICIAL REPORTERS  
OF FELONY CASES FOR  
ARLINGTON COUNTY CIRCUIT COURT  
AND THE CIRCUIT COURT OF  
THE CITY OF ALEXANDRIA

751-0013

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF ILLINOIS  
Eastern Division

----- x  
BALLY MANUFACTURING CO.

Plaintiff,

v. FOR DEFENDANT D. GOTTLIEB & CO. Civil No. 78 C 2246

D. GOTTLIEB & CO.,  
WILLIAM ELECTRONICS, INC.

and  
Houston, Texas 77056

ROCKWELL INTERNATIONAL

Defendants.  
2101 Transco Tower

----- x  
ALSO PRESENT:

Arlington, Virginia

GERSON E. MEYERS, Esq.

Dressler, Goldsmith

Tuesday, July 24, 1979

1800 Prudential Plaza

Deposition of VANCE Y HUM, called for examination  
by counsel for the defendants, pursuant to notice, at  
the offices of Benoit, Smith & Laughlin, 2001 Jefferson  
Davis Highway, Suite 501, Arlington, Virginia, before  
Corrinne H. Myers, a notary public in and for the State  
of Virginia, beginning at 9:45 p.m., when were present  
on behalf of the respective parties:

FOR THE PLAINTIFF:

DONALD L. WELSH, Esq., Fitch, Even & Tabin,  
135 South LaSalle Street,  
Chicago, Illinois 60603

1 A. SIDNEY KATZ, Esq., Fitch, Even & Tabin  
2 135 South LaSalle Street  
3 Chicago, Illinois 60603

4 FOR DEFENDANT WILLIAMS ELECTRONICS INC.

5 MELVIN M. GOLDENBERG, Esq.,  
6 McDougall, Hersh & Scott  
7 135 S. LaSalle Street  
8 Chicago, Illinois 60603

9 Van FOR DEFENDANT D. GOTTLIEB & COMPANY

10 WAYNE M. HARDING, Esq.,  
11 Arnold, White & Durkee  
12 2100 Transco Tower  
13 Houston, Texas 77056

14 JOHN F. LYNCH, ESQ.  
15 Arnold, White & Durkee  
16 2100 Transco Tower

17 Will ALSO PRESENT:

18 Hum GERSON E. MEYERS, Esq.  
19 Dressler, Goldsmith, Clement, Gordon & Shore  
20 Hum 1800 Prudential Plaza  
21 Chicago, Illinois 60601

22 Hum No. 4  
23 HENRY W. TARRING, II, Associate Solicitor,  
United States Patent & Trademark Office

Hum No. 6

Hum No. 7

Hum No. 8

EXHIBITS

I N D E X

MR. TASHIR: I am Henry W. Tashir, Jr.,

Associate Solicitor, United States Patent and Trademark Office, and I would like to examine you in EXAMINATION IN BEHALF OF:

PLAINTIFF DEFENDANT WILLIAMS  
MR. WELSH MR. GOLDENBERG

WITNESS

Vance Hum 125 8, 137  
Mr. Lynch 90  
DEFENDANT GOTTLIEB

Since 1880, the Patent and Trademark Office

has had a policy of refusing to permit examiners to  
EXHIBITS FOR IDENT

- Williams No. 1 (Patent Office application), 8
- Hum No. 2 (Intel- March 21, 1974), 105
- Hum No. 3 (The Great Takeover), 106
- Hum No. 4 (EE/Systems Nov., 1973), 108
- Hum No. 5 (Electronics March 1, 1973), 112
- Hum No. 6 (PPS), 121
- Hum No. 7 (MCS-4), 122
- Hum No. 8 (Electronics July 11, 1974), 125

policy demands that every employee of the Patent and Trademark Office refuse to express to any person any opinion or view as to the invalidity of any United States Patent. The question of validity or invalidity is exclusively a matter



P R O C E E D I N G S

for the courts to determine the validity of the

MR. TARRING: I am Henry W. Tarring, II, Associate Solicitor, United States Patent and Trademark Office, and I would like to make a statement for the record before the deposition begins. The statement is provided to explain the position of the Patent and Trademark Office in regard to testimony sought from patent examiners.

Since 1880, the Patent and Trademark Office has had a policy of refusing to permit examiners to comment concerning their decisions to grant, or to refuse to grant, a patent. That policy is currently expressed in Section 1701 of the Manual of Patent Examining Procedure, which reads, in pertinent part, as follows:

Congress in 35 U.S.C. 282, has endowed every patent granted by the Patent and Trademark Office with a presumption of validity. Public policy demands that every employee of the Patent and Trademark Office refuse to express to any person any opinion or view as to the invalidity of any United States Patent. The question of validity or invalidity is exclusively a matter

1 for the courts to determine. Each member of the  
2 examining corps is cautioned to be especially  
3 wary of any inquiry from any person outside the  
4 Patent and Trademark Office (including any  
5 employee of another government agency), the  
6 answer to which might indicate that a particular  
7 patent should not have been issued.

8 Section 1701.01 of the Manual further  
9 provides that:

10 Inasmuch as public policy does not permit  
11 examiners to decide, as judges in the Patent and  
12 Trademark Office, questions upon which they have  
13 been retained to give opinions as expert witnesses  
14 in patent cases in the courts, every examiner who  
15 shall testify as an expert in a patent case pending  
16 in any court will be dismissed, unless he shall  
17 have to <sup>testify</sup> ~~testified~~ involuntarily, upon compulsion  
18 by competent judicial authority, and without  
19 retainer or preparation,

20 it further provides that:

21 Patent examiners are forbidden to testify as  
22 patent experts or to express opinions, in testimony  
23 or otherwise, as to the invalidity of any issued

1 patent. In the position of the Patent and Trade-  
2 mark Office. In the past when testimony of examiners was  
3 sought by compulsory process, the Courts have recognized  
4 the Office's concern that examiner testimony be re-  
5 stricted to strictly factual matter, in re Mayewsky,  
6 162 USPQ 86 (E.D.Va. 1969); Shaffer Tool Works V.  
7 Joy Manufacturing Co., 167 USPQ 170 (S.D.Tex. 1972).  
8 The protective order which issued in Shaffer Tool  
9 Works v. Joy Manufacturing Co., stated: questions  
10 which exceed "\*\*\*\* the scope of the oral depositions of  
11 the patent examiners <sup>is</sup> hereby limited to matters  
12 of fact and must not go into hypothetical or  
13 speculative areas or the bases, reasons, mental  
14 processes, analyses or conclusions of the patent  
15 examiners in acting upon the patent applications  
16 the maturing into the patent (in suit)." 167 USPQ 171.  
17 Whenever it has been challenged, the court's have, in  
18 effect, found this protective order to define the proper  
19 scope of examiner testimony. In Shaffer Tool Works v.  
20 Joy Manufacturing Co., further reported at 175 USPQ  
21 613 (S.D.Tex. 1972). In Monsanto Co., v. Dawson Chemical  
22 Co., 176 USPQ 349 (E.D.Va 1972), Fischer & Porter Co.  
23 v. Corning Glass Works, 181 USPQ 329 (E.D.Pa. 1974.)  
matter.

1           It is the position of the Patent and Trade-  
2 mark Office that the scope of testimony that may be  
3 properly had of a patent examiner and as demonstrated  
4 by the above protective order is well established in  
5 the law and should govern the scope of testimony that  
6 may be had in this deposition.

7           Accordingly, I am here today representing the  
8 United States Patent and Trademark Office, and I will  
9 advise Examiner Hum, not to answer those questions  
10 which exceed the permissible scope of testimony as  
11 reflected by the previously quoted protective order.  
12 I will be willing to assist counsel rephrase questions  
13 so as to avoid the prohibited area where possible.  
14 However, should an impasse be reached, it will be  
15 necessary for counsel to establish the propriety of  
16 the testimony sought in court before the examiner  
17 will answer.

18           MR. LYNCH: Just for the record, and stated on  
19 behalf of myself and my client, I understand the  
20 position of the patent office. I do not accept, however,  
21 that statement contained in this statement as to what  
22 the law is as being a correct statement. I do hope  
23 we will have no problem, but that is my view of the  
matter.

Whereupon, are your duties as a primary examiner?

A Duties are stipulated in Section MPEP 1004.  
VANCE HUM,

was called for examination by counsel for the defendants,  
and having been first duly sworn, was examined and  
testified as follows:

EXAMINATION IN BEHALF OF WILLIAMS ELECTRONICS

to report BY MR. GOLDENBERG:

Q Would you state, for the record, your name,  
as you ordinarily use it, and give your residence  
address?

A My name is Vance Y. Hum, and I reside at  
3401 Bexhill Place, Kensington, Maryland.

Q Are you employed, sir?

A Yes, sir.

Q By whom?

A The United States Patent and Trademark Office.

Q In what capacity?

A As a patent examiner.

Q How long have you been employed in that  
capacity?

A A little over seven years, I believe.

Q Is your title patent examiner?

A No. I am a primary examiner.

1 Q What are your duties as a primary examiner?

2 A Duties are stipulated in Section MPEP 1004.

3 Q I don't have that with me. Could you tell  
4 me generally what they are?

5 A I have signatory authority. I sign all final  
6 rejections, supervise people who may be assigned to me  
7 to report cases. I decide matters pertaining to re-  
8 issue. In effect, I have full signatory authority  
9 to act, through the director, to act on behalf of the  
10 office. I am not sure when I was...

11 Mr. Q, Approximately how many people or examiners  
12 report to you at any one time? I realize this might vary.  
13 A It varies from zero to two.

14 Q Anyone report to you at this time?

15 A No, although, I am acting in a technical  
16 consultant capacity for other examiners.

17 Q Could you explain what you do as a technical  
18 consultant for other examiners?

19 A I handle, shall we say, any case involving  
20 electronics or electronics related cases, and I pro-  
21 vide other examiners with technical information.

22 Q Is this consultation provided to examiners  
23 who are within your own group, or elsewhere in the

1 Patent Office? Inner?

2 A Basically within my own group.

3 Q Is that an officially assigned duty that you  
4 have, sir? was empowered, I was granted ~~ex~~-partial  
5 signatory. I think you would have to categorize it as  
6 unofficial. or to final action, except for certain  
7 situation. MR. TARRING: Let me ask how much of this  
8 questioning you will have? I really don't see where  
9 all of this has much to do with the facts of the  
10 application. I am not sure when it was handled by  
11 Mr. Hum, but this is more relevant to what his present  
12 duties are. While we are happy to provide a certain  
13 amount of this kind of testimony to help the judge, I  
14 would hope that we don't become deeply involved  
15 in such testimony.

16 Q MR. GOLDENBERG: I don't think we will, and  
17 indeed the purpose of it is to advise the judge as to  
18 what a patent examiner is and what he does. I believe  
19 we are practically at the end of this particular line  
20 of inquiry, I assure you, sir.

21 Q How long have you been a primary examiner?

22 A All Almost a year. and I handle all cases that

23 per Q What position did you hold before you became



1 a primary examiner?

2 A I was an assistant examiner.

3 Q What were your duties as an assistant examiner?

4 A I was empowered, I was granted ~~ex~~ partial  
5 signatory authority, in which case I could sign all  
6 actions prior to final action, except for certain  
7 situations, I believe cases over five years and things  
8 of that matter, spelled out again in MPEP Section 1000,  
9 duties.

10 Q Both as a primary examiner and as an assistant  
11 examiner, is it your responsibility to conduct searches  
12 with respect to applications that are assigned to you,  
13 and then act on those applications depending on the  
14 results of the search?

15 A Yes, sir.

16 Q Would it be correct that your responsibility  
17 is confined to a certain class of technology, or art,  
18 in the Patent Office?

19 A No, sir.

20 Q Would you explain?

21 A I function as an electrical electronics  
22 generalist in the art, and I handle all cases that  
23 pertain or that have electronic or electrical subject



1 matter. It runs a scope of whatever the art is in the  
2 class.

3 Q Could you tell me what art is classified  
4 in the art?

5 A I handled the educational art, the amusement  
6 art, earth working, exercisers, and mechanical pro-  
7 jectors. I also have handled cases in the <sup>biomedical</sup> ~~b-medical~~  
8 area, typewriters, printing, advertising. It is on a  
9 case by case basis.

10 Q How can we identify this art unit?

11 A Art unit 334.

12 Q What is the first position you held in the  
13 Patent Office, was that assistant examiner?

14 A Yes, sir.

15 Q You assumed that position about seven years  
16 ago?

17 A Yes, sir.

18 Q Could you tell me very briefly what your  
19 education after high school was, sir?

20 A I hold a BSEE, and I have had post graduate  
21 courses.

22 Q What insitution is your degree from?

23 A University of Maryland.

1 Q When did you receive that degree?

2 A 1971. was between your graduation from the

3 Q In the course of study for that degree, did you  
4 have a speciality within the electrical engineering  
5 field? Yes.

6 A I guess you would say digital electronics and  
7 computers, but I took just about <sup>every</sup> ~~ever~~ undergraduate  
8 course that they offered. your deposition today, did you

9 Q The postgraduate courses that you referred to,  
10 what were they? Farring in connection with it?

11 A I had training at Goddard Space Flight Center  
12 on telemetry systems with Bendix Field Engineering  
13 Digital Systems Engineering. conversations with anyone

14 other than I am presently enrolled at GW University, on the  
15 the adult education, I guess, night course, for a  
16 computer memory course. I gather you saw Mr. Welsh

17 Q These courses that you had at Goddard Space  
18 Flight Center and under Bendix, were you employees of  
19 any of those companies? matter?

20 A I was employed by Bendix Field Engineering.  
21 We were prime contractors there. position as referred

22 Q Was that before you assumed your position in  
23 the Patent Office? the deposition. Beyond that, I

1 don't A Yes. There are any other specifics that we

2 Q That was between your graduation from the  
3 University of Maryland and the assumption of your  
4 position in the Patent Office?

5 A Yes. TARRING: I don't know that I care to

6 Q Was that job about a year or so?

7 A About a year and a half, a little over a year.

8 Q Prior to giving your deposition today, did you  
9 do anything to prepare for this deposition beyond  
10 talking to Mr. Tarring in connection with it?

11 A I read over the application this morning,  
12 the patent file, I mean. I have no objection to rendering

13 Q Have you had any conversations with anyone  
14 other than Mr. Tarring in connection with this deposition?

15 A No. GOLDENBERG: My contact, sir, was simply  
16 to arrange for MR. GOLDENBERG: I gather you met Mr. Welsh  
17 yesterday, Mr. Tarring. Are you willing to tell us  
18 what conversation you had with the attorneys for Bally  
19 in connection with this matter?

20 MR. TARRING: I have no objection. I think I  
21 the discussion centered upon our position as reflected  
22 in that protective order, and what they thought might  
23 be forthcoming at the deposition. Beyond that, I have

1 don't think there are any other specifics that we  
2 went into.

3 MR. GOLDENBERG: Would you tell me what they  
4 thought might be forthcoming?

5 MR. TARRING: I don't know that I care to  
6 characterize their statements.

7 MR. LYNCH: I would think these conversations  
8 should be open. There certainly shouldn't be a situation  
9 where a government lawyer undertakes to advise one side  
10 of the litigation and refuses to tell the other side  
11 what those conversations were.

12 MR. TARRING: I have no objection to rendering  
13 advise. I think I have been contacted by your firm  
14 with respect to what our position is.

15 MR. GOLDENBERG: My contact, sir, was simply  
16 to arrange for the deposition; can you agree with that?

17 MR. TARRING: I think so. I frankly don't  
18 really recall.

19 MR. GOLDENBERG: I did not speak with you  
20 about what might be forthcoming at this deposition. I  
21 think that is quite a different kind of thing, and I  
22 do think we are entitled to know what a government  
23 lawyer, what conversations, a government lawyer may have

1 had with the plaintiff's attorney in this case. I  
2 think it is very critical. *ing in the Patent Office,*  
3 and *con-* MR. TARRING: Well, I think they were con-  
4 cerned that there may be some difficulty in segregating  
5 the present case from another case, or other cases,  
6 which have not issued as patents, and I think that  
7 was their principal concern. *try here today would be*  
8 *limited to* MR. GOLDENBERG: Did they make any -- *itted to*  
9 *extend to* MR. LYNCH: I don't quite understand that;  
10 segregating in what context? *is under the statutory*

11 *cloak of* MR. TARRING: In the sense of his recollection.

12 MR. LYNCH: You are talking about segregating  
13 the case in issue from other cases of Bally that Mr.  
14 Hum might also have been involved with; is that the  
15 problem? *ide that communications with the Patent Office*

16 *shall be* MR. TARRING: Yes, there is a public record  
17 of that. *MR. GOLDENBERG: Did they identify any such*  
18 *case to you, sir? Patent Office orally, and they are*

19 not in writing. MR. TARRING: Not especially. I think they  
20 did mention a patent, but I don't recall it -- not  
21 a patent, but an applicant's name. *to communicate*

22 *with the* MR. GOLDENBERG: Was it Bocker?  
23 *ore, not* MR. WELSH: I would like to raise an objection  
*communication can become lost. And if it is a*

1 at this point, that any information with respect to  
2 any patent application pending in the Patent Office,  
3 and communications between counsel for the applicatn  
4 and the Patent Office is secret. I might say further  
5 that was the basis of our concern with respect to Mr.  
6 Tarring in our conversations with him to inquire those  
7 really as to whether the inquiry here today would be  
8 limited to the issued patent, and not be permitted to  
9 extend to any other application which has not issued  
10 as a patent, and which perhaps is under the statutory  
11 cloak of secrecy.

12 MR. GOLDENBERG: Perhaps we can excuse Mr.  
13 Hum until we have this matter resolved.

14 MR. LYNCH: It seems to me the rules of prac-  
15 tice provide that communications with the Patent Office  
16 shall be in writing, so that there is a public record  
17 of that communication. Now insofar as the communications  
18 were made with the Patent Office orally, and they are  
19 not in writing, I don't believe such communications  
20 enjoy any such privilege of secrecy.

21 It is improper for counsel to communicate  
22 with the Patent Office not in writing, and it is, there-  
23 fore, not under the ambit of protection since that  
communication can become lost. And if it is a

1 communication in connection with any pending application,  
 2 and this lawsuit. And if the one of primary concern today or another  
 3 Mr. Tarring was in connection with this application and  
 4 patent application of Bally relating to a similar field,  
 5 this lawsuit, I think we are on the same ground. Mr.  
 6 I would like to say if that statement is not in writing,  
 7 Welsh, the entire conversation.

8 it does not enjoy any protection or any guardianship  
 9 of secrecy. That is my position with respect to those  
 10 MR. GOLDENBERG: If you have chosen, in a  
 11 matters.

12 conversation in connection with this lawsuit, to bring  
 13 I think the Solicitor's Office would be con-  
 14 in some other application assigned to Bally, it seems  
 15 strained to agree that such communications have to be  
 16 to be that you waived any claim to secrecy in connection  
 17 in writing.

18 with the matters discussed, at the very least; if not  
 19 MR. TARRING: I really don't want to get into  
 20 the entire application.

21 this argument, and I don't know in the abstract what  
 22 MR. WELSH: I disagree strenuously with you  
 23 you are referring to. We have to look at it on a case  
 24 regarding that. I inquired into the scope of the  
 25 by case basis.

26 examination permitted by the Patent Office Solicitor's  
 27 MR. LYNCH: The rules so specify.  
 28 Office.

29 MR. WELSH: I might say that even written  
 30 MR. GOLDENBERG: Mr. Tarring, I ask this: I  
 31 communications are secret until and unless a patent  
 32 assure the plaintiff's attorneys you were talking about  
 33 issues.

34 were Mr. Welsh and Mr. Katz, is that correct?

35 MR. GOLDENBERG: I would add, also, the

36 MR. TARRING: Correct.  
 37 plaintiffs by seeking out the Solicitor's Office,

38 MR. GOLDENBERG: Did they make any suggestion  
 39 and Mr. Tarring, to discuss this deposition, it seems  
 40 or proposals to you how the scope of this deposition  
 41 to me very certainly waived any claim of secrecy that  
 42 could be limited?

43 they might have with respect to any matter discussed



1 with Mr. Tarring. We are concerned with this deposition,  
2 and this lawsuit. And if the whole purpose of seeing  
3 Mr. Tarring was in connection with this deposition and  
4 this lawsuit, I think we are entitled to know, Mr.  
5 Welsh, the entire conversation.

6 MR. WELSH: Mr. Tarring has summarized it.

7 MR. GOLDENBERG: If you have chosen, in a  
8 conversation in connection with this lawsuit, to bring  
9 in some other application assigned to Bally, it seems  
10 to be that you waived any claim to secrecy in connection  
11 with the matters discussed, at the very least; if not  
12 the entire application.

13 MR. WELSH: I disagree strenuously with you  
14 regarding that. I inquired into the scope of the  
15 examination permitted by the Patent Office Solicitor's  
16 Office.

17 MR. GOLDENBERG: Mr. Tarring, I ask this: I  
18 assume the plaintiff's attorneys you were talking about  
19 were Mr. Welsh and Mr. Katz, is that correct?

20 MR. TARRING: Correct.

21 MR. GOLDENBERG: Did they make any suggestions  
22 or proposals to you how the scope of this deposition  
23 could be limited?



1           A       MR.. TARRING:   None.

2           Q       MR.. GOLDENBERG:   Did you make any proposals  
3 or suggestions to them?

4           A       MR.. TARRING:   I suggested to them that if  
5 they recognize a question as being directed more to  
6 something that might have occurred in another applic-  
7 tion that has not issued as a patent, they let us  
8 know about it, because I am not sure I would recognize  
9 the situation.   That is about the extent of it.

10          A       MR. WELSH:   As long as we are speaking about  
11 propriety, I would like to say that it would surely be  
12 improper to use this proceeding to seek information  
13 in regard to a pending application that is not  
14 otherwise available.

15          Q       MR. GOLDENBERG:   I believe we have the right  
16 to go into all matters which are in the interests of  
17 our respective clients and arise out of the events  
18 which caused this lawsuit.

19          BY MR. GOLDENBERG:

20          Q       I show you a copy of United States Patent  
21       4093232  
22       4094342, which has previously been marked in proceedings  
23 in this case as Deposition Exhibit WD 17, and I ask  
you, sir, if you have ever seen that patent before?

1 A Yes, sir.

2 in Q Were you the patent examiner who was  
3 responsible for the application for that patent?

4 A Yes, sir.

5 Q Does that mean you examined it in the Patent  
6 Office parlance, and I am putting examined in quotes?

7 A Yes.

8 A Were you the only examiner who had any  
9 responsibility in connection with that application?

10 A Other than the signing, I wasn't assistant  
11 examiner at that time; on the merits, yes.

12 Q You said other than the signing, does that  
13 mean, sir, in connection with any paper that was  
14 mailed out representing a Patent Office action, you  
15 had to obtain somebody else's signature?

16 A My supervisor.

17 Q Who was that, sir?

18 A Mr. Richard C. Pinkham.

19 Q Was he your supervisor during the entire  
20 period that the patent was pending?

21 A Yes, I believe so.

22 Q Is he still your supervisor?

23 A Yes.

1 Q Have you ever had occasion to read the patent  
2 in the form in which it issued? you, I have here a

3 A Not totally. file record of contents which has

4 Q Part of it? litigation as Deposition Exhibit

5 A Parts of it. first office action was mailed

6 Q What role was played by Mr. Pinkham in the  
7 process of examining the application for the patent?

8 A I guess you might categorize his function  
9 as strictly adviser. with the action that you were

10 Q Would it be correct, sir, when the application  
11 was first filed and taken up for examination, that you  
12 made the prior art search that was carried out by the  
13 Patent Office? I be responsible for signing the action.

14 A Yes. February of 1976 or about that period of

15 Q What Mr. Pinkham did not participate in that search?

16 A No. Mr. Pinkham about?

17 Q With the results of that search in hand, you  
18 prepared the first Patent Office action on the  
19 application, is that correct? Tarring conferred.

20 A Yes. ically, it was on my judgment whether or

21 Q Was it reviewed with Mr. Pinkham before it  
22 was transmitted to the applicant?

23 A I don't remember. nothing more in an applicati.

Q Do you remember what your practice was, at that time, and if it might help you, I have here a certified copy of the file record of contents which has been marked in the litigation as Deposition Exhibit WD 18. It appears the first office action was mailed by the Patent Office in February 26, 1976. My question would be, having that date in mind, what was your usual practice with respect to consulting with Mr. Pinkham in connection with the action that you were taking on applications?

A Depending on the issues, I would not have to report case to Mr. Pinkham prior to signature. In any event, he would be responsible for signing the action.

Q In February of 1976 or about that period of time, what kinds of issues would you be required to consult with Mr. Pinkham about?

A May I confer with counsel a moment?

A Sure.

(The witness and Mr. Tarring conferred.

A Basically, it was on my judgment whether or not I needed some suggestions, or case law, whatever from Mr. Pinkham.

Q If you were doing nothing more in an application

1 than making a search, and then proposing to reject the  
 2 application, as you did here under 35 U.S.C. Section 112  
 3 and 103, is that the kind of matter that you would WD 1  
 4 consult with Mr. Pinkham about? the question as  
 5 leading, MR. WELSH: I object to this question as hypo-  
 6 thetical. to what he did in this particular case.

7 MR. GOLDENBERG: I am trying to get the wit-  
 8 nesses experiences and practices at a specific point in  
 9 time. THE WITNESS: Would you repeat that question,

10 please? MR. TARRING: I agree it is a hypothetical  
 11 question. We allow a certain degree of general practice  
 12 questioning. I don't think we allow what an examiner's  
 13 experience is when it is described as to be specific  
 14 to one or two cases. I think that is a general question  
 15 and I see no problem with his responding to it. February 26

16 1976, as THE WITNESS: Would you rephrase the question,  
 17 please??

18 Q Do you want me to rephrase it or would you  
 19 rather have the question read back? so all in

20 on A Just have it read back. Exhibit WD 18, as  
 21 to whether (Question read back.) Mr. Pinkham at any time?

22 A Maybe. YUCH: I take it Mr. Tarring, you have

23 Q You have no recollection, one way or the other,

1 as to whether you consulted with Mr. Pinkham in  
2 connection with this first office action on the appli-  
3 cation for the patent, which is Deposition Exhibit WD 18?

4 MR. WELSH: I object to the question as  
5 leading, and this witness hasn't testified at all with  
6 respect to what he did in this particular case.

7 COMMENT. MR. TARRING: I would advise the examiner  
8 he can answer that yes, no, or he doesn't remember.

9 THE WITNESS: Would you repeat that question,  
10 please?

11 BY MR. GOLDENBERG:

12 Q Let me rephrase it.

13 Do you have any recollection, one way or the  
14 other, with respect to the first office action in the  
15 application here which action was mailed on February 26,  
16 1976, as to whether or not you consulted with Mr.  
17 Pinkham?

18 A No.

19 Q Do you have any recollection at all in  
20 connection with this application, Exhibit WD 18, as  
21 to whether you consulted with Mr. Pinkham at any time?

22 MR. LYNCH: I take it Mr. Tarring, you have  
23 the file history here?

1 MR. TARRING: Q Correct. I believe the record should

2 now show MR. LYNCH: A Is that available for us to look  
3 at at sometime or other during these proceedings?

4 connectic MR. TARRING: A As long as it doesn't leave  
5 my custody. MR. GOLDENBERG: A

6 Q MR. LYNCH: A I understand. A I was going to  
7 comment, if you were going to show that to the examiner,  
8 which you haven't done yet, it is our general practice  
9 to bring along the file wrapper to the deposition. It  
10 is a Patent Office file record and must remain in the  
11 custody of the Patent Office, and not leave our custody.  
12 However, in many cases, it is more convenient for the  
13 examiner to work out of the official file, rather  
14 than work out of a certified copy with which is in-  
15 experienced. currence, or thing, or action that you took

16 in connect MR. LYNCH: A That's what I was getting at. A  
17 Whether we can do it that way, and whether that is  
18 done. I was going to ask whether the examiner could  
19 refer to the official Patent Office copy.

20 Q MR. TARRING: A Yes. the entire period from the

21 time the MR. GOLDENBERG: A In this connection, could  
22 that be made available to Mr. Hum at this point in time?

23 at the MR. TARRING: A Sure. A of you, you will find



1 that MR. GOLDENBERG: I believe the record should  
 2 now show that Mr. Tarring has placed in front of Mr.  
 3 Hum the official record of the Patent Office in a  
 4 connection with this application for the patent.

5 A BY MR. GOLDENBERG: e to answer that maybe.

6 Q Mr. Hum, when you picked up the application  
 7 for the patent that ensued to act on it, what was the  
 8 first thing you did, sir? f time?

9 A I read the case. this point, the question is  
 10 broad Q Do you have any specific recollections about  
 11 what you did in connection with the examination of the  
 12 patent that ensued? e physical facts, if he recalled  
 13 it, A I am not sure I understand. kinds of sea.

14 I will Q Do you have any recollection of any kind of  
 15 event, or occurrence, or thing, or action that you took  
 16 in connection with the examination of the application  
 17 that ensued? WELSH: I object also to the

18 calling MR. WELSH: ARE you speaking of the entire  
 19 time of the examination? the question is

20 that Q I am speaking of the entire period from the  
 21 time that you began to examine this application until  
 22 the last action you took, and I think if you will look  
 23 at the file history in front of you, you will find



1 that period extended, apparently from sometime in  
2 early 1976 to 1978.

3 MR. TARRING: You can answer that with a  
4 yes or no.

5 A I think I would have to answer that maybe.

6 Q Could you tell me the recollection or recollec-  
7 tions that you have in connection with the examination  
8 process over that period of time?

9 MR. TARRING: At this point, the question is  
10 broad enough that you could be going into the thinking  
11 with the case, unless he understand that you are  
12 referring only to the physical facts, if he searched  
13 it, where he searched it, and those kinds of features.  
14 I wish you would limit your question to the physical  
15 facts of what happened without going into the mental  
16 process.

17 MR. WELSH: I object also to the question as  
18 calling for a narrative and recollection over a long  
19 period of time. I think the question is indefinite in  
20 that regard, too.

21 MR. GOLDENBERG: I do not believe I am calling  
22 for a narrative, and I think your comments are well  
23 taken. Indeed, sir, what I am inquiring about are

1 specific events or facts, not your thinking or what  
2 was in your mind at that time. Do you understand that,  
3 sir?

4 THE WITNESS: Yes.

5 BY MR. GOLDENBERG:

6 Q I would ask you to recite those events, those  
7 facts that you recall in connection with the examination  
8 process for this application.

9 MR. GOLDENBERG: Is that satisfactory?

10 MR. TARRING: I think that is satisfactory. I  
11 am a little perplexed frankly, because his answer to  
12 the previous question was maybe. I don't know what  
13 the source of the maybe is, whether he recalls anything  
14 really.

15 Q Do you recall anything?

16 MR. WELSH: I continue my objection as to the  
17 indefiniteness of the question, because it does not  
18 permit Mr. Tarring to determine on a question by  
19 question basis whether the fact is being called for or  
20 some mental process is being called for. I think the  
21 question is too general in that regard.

22 MR. LYNCH: I think Mr. Tarring should be  
23 allowed to fend for himself.

1 MR. TARRING: Could I suggest you ask him the  
2 basis for the maybe, whether he recalls anything or  
3 what the basis for the maybe is.

4 BY MR. GOLDENBERG:

5 Q And Let's do that, Mr. Hum. You understand I  
6 want your best recollection and do not want you to  
7 speculate, but what is the basis for your answer maybe  
8 in response to that question a few moments ago?

9 A As I referred to earlier in the deposition, I  
10 am an electrical generalist, and I handle a number of  
11 cases which relate to this art in particular. I am  
12 not sure whether or not some of the events may have been,  
13 with respect to these other applications, or with  
14 respect to this one, in this case I think I would have  
15 to answer I don't remember in those instances. If you  
16 could direct the questions to specific events, I  
17 could possibly answer the question.

18 Q Specifically, do you recall any interviews that  
19 you had with one or more attorneys prosecuting the  
20 application for the Patent Office?

21 A Vaguely, yes.

22 Q Could you give me the extent of that  
23 recollection, sir?

1 A May I consult with counsel for a moment?

2 Q Yes. Would you turn to page 17 of that amendment?

3 (Whereupon, the witness and Mr. Tarring conferred.)

4 A In some of the interviews, I can recollect  
5 bits and pieces; others, I can't, without going into  
6 the file. Please state it; otherwise, please don't

7 Q Let me direct your attention to Amendment C  
8 filed on October 19, 1977. I cannot identify the  
9 paper number. At the bottom of the page, and I note

10 a reference. MR. TARRING: What was the date?

11 MR. GOLDENBERG: Amendment C was filed on  
12 October 19, 1977. A. Sidney Katz.

13 MR. TARRING: We have an amendment C that was  
14 filed on February 22, 1977. Was the first interview

15 with an MR. GOLDENBERG: I am sorry. This is labelled  
16 Amendment C, and perhaps it is really Amendment D. I  
17 guess there was a cross of documents in the mail or  
18 something like that.

19 MR. TARRING: We have located a paper that was  
20 filed on October 19, 1977, right ahead of Amendment C  
21 and marked in ink on the righthand corner as 11/D.

22 MR. GOLDENBERG: Does that mean paper number 11  
23 and, in fact, it was amendment D? The document remains

1 in front MR. TARRING THAT would be my interpretation.

2 Q Could you turn to Page 17 of that amendment?

3 objection MR. WELSH: Do I understand the purpose of  
4 this is for him to refresh his recollection?

5 that is MR. GOLDENBERG: If you have an objection,  
6 Mr. Welsh, please state it; otherwise, please don't  
7 interfere with my deposition.

8 Q I direct your attention to the first paragraph  
9 and the remarks at the bottom of the page, and I note  
10 a reference to an interview of June 14, 1977, by the  
11 undersigned attorney. The undersigned attorney in  
12 that amendment is A. Sidney Katz.

13 A Do you have any recollection of that inter-  
14 view, sir? I believe that was the first interview  
15 with an applicant's attorney appearing in the file.

16 in A In part, yes.

17 Q Could you state what you recall about that  
18 interview?

19 MR. WELSH: Now, that the witness has finished  
20 looking at the document, is it proper that it be  
21 removed so that he testifies from his own recollection,  
22 rather than with respect to references to the document.  
23 I object to the question first, if the document remains

1 in front of him. something you said to Mr. Katz?

2 A MR. GOLDENBERG: I don't understand that  
3 objection. R. TARRING: Let me advise the examiner  
4 to the Q: ex Could I have your recollection, sir, about  
5 that first interview with Mr. Katz? it would be  
6 to the A: if we discussed in the inclusion of pinball  
7 type limitations. ned, back and forth, what  
8 that Q: is o Do you recall how long the interview lasted?  
9 by the A: r No, sir. ion of the specific facts.

10 Q You have no idea? a inquiring about  
11 said A: o No. Katz, and what Mr. Katz said to

12 Q Is it likely that it lasted more than an hour?

13 A: yo I have no recollection of that.

14 Q Could you elaborate on this discussion with  
15 Mr. Katz about the inclusion of the pinball limitation  
16 in the claims?

17 A MR. WELSH: I object to the question as  
18 calling for a narrative rather than being specific,  
19 indefinite. I believe I stated to prior  
20 hat A: and I am not sure whether or not I would be vocal-  
21 izing opinions as to what occurred. I don't remember  
22 the entire events. I just remember that I had mentioned  
23 the inclusion of pinball limitations in the claim.

1       Q     This is something you said to Mr. Katz?

2       A     Yes.

3       MR. TARRING: Let me advise the examiner here  
4     to the extent that things were said and what have you,  
5     if they might encompass an opinion, it would be okay  
6     to testify to them, if you remember. So far as dis-  
7     cussion is concerned, back and forth, what was said,  
8     that is okay to testify to as a fact. It is limited  
9     by your recollection of the specific facts.

10      Q     Mr. Hum, what I am inquiring about is what you  
11     said to Mr. Katz, and what Mr. Katz said to you.

12      A     Okay, I understand.

13           Do you have any recollection of that, sir?

14      A     To some extent, yes.

15      Q     Could you give me the extent of that  
16     recollection?

17      A     We discussed including in the claims, limi-  
18     tations for example of flippers, a moving ball, and  
19     the like. I believe I referred to prior actions. Mr.  
20     Katz indicated that the claims, that he wanted to  
21     include more than just the pinball, the horizontal  
22     type pinball field.

23      Q     Did he tell you what other kind of game he



1 wanted to include?

2 A I don't think we identified it specifically,  
3 but substantially vertical type projectile games.

4 Q Target games?

5 A I don't know if it would be proper -- let  
6 me consult with counsel for a second.

7 (The witness and Mr. Tarring consulted.)

8 Q Please continue.

9 A We discussed the possibility of substantially  
10 vertical playfields with a surface projectile.

11 Q With a surface projectile. Was any particular  
12 game identified?

13 A No.

14 Q Was this a game with a moving ball on it of  
15 some kind?

16 A Yes.

17 Q Was it a game called Pachinko?

18 A We didn't discuss that term specifically. We  
19 didn't use that term specifically.

20 Q From your understanding, was the game Pachinko?

21 MR. WELSH: Object to the question. Calls  
22 for understanding.

23 MR. TARRING: I think this was the source of



1 our discussion off the record. Insofar as he has a  
2 recollection of what he said and what have you, back  
3 and forth, during the interview, of course he may  
4 answer. Insofar as he might draw a mental impression,  
5 I think it is getting into verbotin area.

6 MR. GOLDENBERG: I withdraw the question.

7 Q Do you recall specifically what Mr. Katz  
8 said to you about other kinds of games he would like  
9 to try to cover?

10 A No. This is it.

11 Q This vertical surface with some kind of pro-  
12 jectile. Was that a ball, as he explained it to you?

13 A I don't remember if he explained it to me or  
14 I explained it to him.

15 Q Was it a ball as you explained it to him?

16 A I believe it was.

17 Q How was the ball to be put into motion?

18 A We didn't discuss it.

19 Q Do you recall anything else that was discussed  
20 at that interview with Mr. Katz?

21 A We discussed the inclusion of software, I  
22 believe.

23 Q Can you tell me what that discussion was about?

1 A MR. WELSH: Object to that question. It  
2 calls for him to characterize the conversation.

3 A MR. GOLDENBERG: I withdraw the question.  
4 inter Q: Would you tell me the substance of that  
5 discussion? TARRING: I am not sure.

6 MR. WELSH: Same objection.

7 at the time MR. TARRING: I think Mr. Hum knows the  
8 limitations on what he can say now. I will be a little  
9 bit liberal as far as the questions are concerned.

10 Q Mr. Hum, when I say that, what I am inquiring  
11 about what you said to Mr. Katz and what Mr. Katz said  
12 to you. I do not expect you to recall the precise  
13 words; that is why I used the word substance.

14 A With respect to the 112 Paragraph 1 issue, I  
15 wanted the software made available for examination.

16 in the Q You told that to Mr. Katz?

17 a Yes. WELSH: Object to the question.

18 for Q What did he respond? No objection.

19 is A I don't remember. No objection.

20 and Q Do you recall whether or not a resolution was  
21 reached with respect to that matter?

22 was A Yes. No objection.

23 at Q Do you recall what that resolution was?

1 if A Yes. would be taken is a factual question and  
 2 nothing Q Could you tell me?

3 A Upon re-examination of the file after the  
 4 interview-- of his mental process or impression, I  
 5 think the MR. TARRING: ab I am not sure, is this-- at  
 6 what Q My question at this point was a resolution  
 7 at the time of that meeting. limitation. I see no  
 8 prob A No. your answering that.

9 Q No resolution. agreed to the language a moving  
 10 mass A No.

11 Q I gather, sir, there was a resolution reached  
 12 with respect to that matter later in time?

13 A Yes. n't remember.

14 Q Was there any agreement between you and Mr. Katz  
 15 as to how the claims would be amended to bring  
 16 in the pinball limitations that you were seeking?

17 Q MR. WELSH: an Object to the question as calling  
 18 for his opinion as to agreement. No objection if there  
 19 is an inquiry as to what was said between the examiner  
 20 and Mr. Katz, but that calls for his mental processes.  
 21 other than MR. GOLDENBERG: I think as to whether there  
 22 was an agreement between the examiner and interviewing  
 23 attorney as to what course of action would be taken, or

1 Q Was Mr. Katz alone at the time of this interview  
2 if any action would be taken is a factual question and  
3 view or was he accompanied by anybody?  
4 nothing more.

5 A He was alone.

6 MR. TARRING: While it might call, in the  
7 broad aspect of his mental process or impression, I  
8 what I would ask you to do is to review the  
9 broad aspect of his mental process or impression, I  
10 remarks starting at page 17, and see if -- and it is  
11 think that it is probably a fair question to get at  
12 about three and a half pages -- see if that refreshes  
13 what transpired at the interview. I think the examiner  
14 your recollection to any degree about what happened  
15 is pretty well aware of the limitation. I see no  
16 at that interview. Could you do that?  
17 problem with your answering that.

18 Q Would you review or read the remarks of the  
19 A We tentatively agreed to the language a moving  
20 amendment in front of you, or any other part of the  
21 mass.

22 Q amendment that you care to look at, and then tell me  
23 Q Do you recall who suggested that language,  
24 whether or not your recollection is refreshed about  
25 sir, was it you or Mr. Katz?  
26 what was said or done at that meeting?

27 A I don't remember.

28 A Yes.

29 Q Did Mr. Katz make any arguments or statements  
30 Q After reviewing this document in front of  
31 to you as to why that language should be used?  
32 you, sir, has your recollection been refreshed to any

33 A I don't remember.  
34 degree as to what was said or done at that interview?

35 Q Was there any discussion of the prior art at  
36 A Yes.  
37 the time of that interview?

38 A I really don't remember.

39 A Yes, apparently a paper or an article was  
40 Q Do you have any remembrance of that meeting,  
41 sent out on the merits, and I declined to do so  
42 other than that which you testified about?  
43 those matters with respect to the prior art?

44 A I think I would have to answer I don't re-  
45 interview until after he had received the paper  
46 member.

1 Q Was Mr. Katz alone at the time of this inter-  
2 view or was he accompanied by anybody?  
3 the prior art at the time of that interview?

4 A He was alone.

5 A Not to my recollection.

6 Q What I would ask you to do is to review the  
7 remarks starting at Page 17, and see if -- and it is  
8 conversation referred to in the remarks accompanying  
9 about three and a half pages -- see if that refreshes  
10 this amendment that you have in front of you at this  
11 your recollection to any degree about what happened  
12 time, and I direct your attention to the paragraph  
13 at that interview. Could you do that?  
14 beginning at the bottom of page 10?

15 Would you review or read the remarks of the  
16 amendment in front of you, or any other part of the

17 Q Could you give me your recollection, sir, as  
18 amendment that you care to look at, and then tell me  
19 to what you said to Mr. Katz and what Mr. Katz said to  
20 whether or not your recollection is refreshed about  
21 you in the course of the telephone interview that is  
22 what was said or done at that meeting?  
23 referred to there?

A Yes.

A I believe Mr. Katz indicated to me that the

Q After reviewing this document in front of  
software had been filed with the original specification.  
you, sir, has your recollection been refreshed to any  
As evidence, I believe he pointed out a particular  
degree as to what was said or done at that interview?  
paper in substantiation of that fact, and I took the

A Yes.

case under advisement.

Q Could you tell me what you now remember?

A After taking the case under advisement, what

A Yes, apparently a paper or an action had been  
did you do then?

sent out on the merits, and I declined to discuss

MR. TAKAHASHI: I advise the examiner that you  
those matters with respect to the prior art during that  
don't get into mental processes.

interview until after he had received the action.

Q I am talking about actions or communications

1 Q So you now recall there was no discussion of  
2 the prior art at the time of that interview?

3 A Not to my recollection.

4 Mr. Q Do you have any recollection of the telephone  
5 conversation referred to in the remarks accompanying  
6 this amendment that you have in front of you at this  
7 time, and I direct your attention to the paragraph  
8 beginning at the bottom of Page 18?

9 A Yes.

10 Q Could you give me your recollection, sir, as  
11 to what you said to Mr. Katz and what Mr. Katz said to  
12 you in the course of the telephone interview that is  
13 referred to there?

14 A I believe Mr. Katz indicated to me that the  
15 software had been filed with the original specifications.  
16 As evidence, I believe he pointed out a particular  
17 paper in substantiation of that fact, and I took the  
18 case under advisement.

19 Q After taking the case under advisement, what  
20 did you do then?

21 MR. TARRING: I advise the examiner here you  
22 don't get into mental processes.

23 Q I am talking about actions or communications

1 with the applicant. Q: I take it you would advise

2 A I don't believe I communicated with the  
3 applicant. I do believe I discussed the matter with  
4 Mr. Pinkham. I had resolved in my mind --

5 Q MR. TARRING: Wait a minute. I don't think  
6 you want to get into the conclusions you reached in  
7 your mind. by the sentence starting in the second line,

8 Q You believe you discussed the matter with Mr.  
9 Pinkham? Upon reading that, sir, does that reflect

10 A Yes. your recollection to any degree as to what you did in

11 Q connection? Could you tell me the substance of that  
12 discussion, sir?

13 A <sup>TARRING</sup> MR. TARRING: Here, insofar as communications  
14 between examiners within the office, it is our view  
15 that is part of the decision making process. I would  
16 cite the grandfather case in this area, United States  
17 versus Morgan, a Supreme Court decision on which most  
18 of the examiner testimony restrictions flow. That one  
19 appears to be the specific type of situation the  
20 Supreme Court contemplated in that case, between  
21 people in the decision making agency, if you will. I  
22 don't think it is appropriate to get into discussions  
23 between examiners, if you will.



1 who, I MR. GOLDENBERG: I take it you would advise  
2 the witness not to answer.

3 software MR. TARRING: Yes, advise him not to answer.

4 in the BY MR. GOLDENBERG:

5 the Q I direct your attention to the paragraph  
6 beginning at the top of Page 19 of the Amendment, and  
7 particularly the sentence starting in the second line,  
8 continuing to the end of that paragraph.

9 A Upon reading that, sir, does that refresh  
10 your recollection to any degree as to what you did in  
11 connection with the matter after taking it under  
12 advisement?

13 A Yes, to some extent, but it involved opinion  
14 to some extent.

15 Q What you did would involve opinion?

16 A In terms of the decision made on this issue  
17 to some extent, yes.

18 Q Perhaps my question was not clear, but I note  
19 in that sentence that I referred to is an indication  
20 that the examiner, and I take it you were the examiner,  
21 called the undersigned attorney. Did you do that, sir?

22 A Yes, I did.

23 Q What did you say to the undersigned attorney

1 who, I believe, to be Mr. Katz? of it, if that is  
2 possible. I mentioned the fact that apparently the  
3 software had been misfiled, or in any event, it wasn't  
4 in the application for the previous rejection, but at  
5 the time I talked to Mr. Katz, the paper was in the  
6 file and that I -- may I speak with counsel for a  
7 second? What facts led you to believe that it was

8 Q Yes, please.

9 A During the telephone interview, I indicated  
10 to Mr. Katz that I thought that the software was in the  
11 case initially, but during prosecution had been  
12 somehow mislaid. At the time of this interview was  
13 back in the file, and that I considered a rejection  
14 under 112, Paragraph 1 to be in error and that I paper  
15 would withdraw it. 12, 1975 and Form PO 1082 or 1062,

16 and Q What led you to think that the software was  
17 in the application originally, sir? indicates docket  
18 number and MR. WELSH: I object to that question as  
19 clearly calling for his mental impressions. It is  
20 asking what he thought. that paper, sir?

21 A MR. TARRING: It is going to his mental  
22 process, but it is not going to his decision making  
23 process, so viewing it that way, as long as we can keep

1 the decision making process out of it, if that is  
2 possible, it will be okay to answer it.

3 A Do you understand?

4 THE WITNESS: Yes.

5 A I am not certain whether or not I can segre-  
6 gate the decision making process.

7 Q What facts led you to believe that it was  
8 in the file originally?

9 A As pointed out by applicant's counsel with  
10 respect to particular paper, apparently the transmittal  
11 papers on filing of the application.

12 Q What transmittal paper do you have reference  
13 to?

14 MR. TARRING: Could I identify it as a paper  
15 that is dated May 12, 1975 and Form PO 1082 or 1062,  
16 and apparently signed by Mr. Egr Sewall.  
17 The first blank on the page indicates docket  
18 number and the blank is filled in C-3987-1 dated  
19 May 12, 1975.

20 Q What is it on that paper, sir?  
21 The box marked E logic sequence to be made  
22 part of the file.

23 Q Was there anything else that led you to

1 believe that the software listing was or had in fact  
2 been filed with the application? out of there, it was

3 A Possibly, but it would involve some of my  
4 own impressions. was.

5 Q Where did you find the software listing  
6 physically at the time you went to look for it after  
7 this telephone conversation with Mr. Katz, and while  
8 you were taking the matter under advisement? I be in a

9 A Inbetween some of the papers. I don't  
10 remember where specifically. he can't answer the question,

11 Q But it was in the file wrapper?

12 A Yes, at the time of the interview, telephone  
13 interview. reason why. It gives his opinion as to

14 Q Was it bound in with the other papers?

15 A Yes. GOLDENBERG: That question can be answered

16 Q Was there a patent office stamp on them, or  
17 do you recall? HARRING: It's all right/na.

18 A I don't remember without looking.

19 Q With respect to the file that is in front of  
20 you right now, could you show me where the software  
21 listing is? I consult with counsel?

22 A I am not entirely certain, but I think this  
23 is the copy. I don't know the reason why it is out

Q At this time, it was not bound in the file, was it, when you just pulled it out of there, it was loose in the file?

A Yes, it was. It may or may not be identical

Q Do you have any explanation as to why it should be loose in the file? I am going to call a cover sheet bearing MR. WELSH: Object to this question. Sequence in MR. TARRING: I don't think he would be in a position. Front of you?

MR. GOLDENBERG: If he can't answer the question, he can say so. What I read is in the file in front of you.

MR. WELSH: I think it is an improper question, it gives a reason why. It gives his opinion as to why something is there. In the file following copy

MR. GOLDENBERG: That question can be answered with a very simple yes or no. Is that letter in the file with

MR. TARRING: It's all right/me. correct?

Q Could you answer it, sir?

MR. WELSH: I would like to make a further objection to this question as lacking a foundation.

A May I consult with counsel?

A Surely. Can you answer the question, sir?

A No. I don't know the reason why it is out

of the file, and the copy on the right-hand side of

1 of the file.

2 Q Mr. Hum, I have in my file, WD 18, which is  
3 a certified copy of the file wrapper and contents,  
4 a program listing which may or may not be identical  
5 with what you have there. I believe it to be, but  
6 it does include what I am going to call a cover sheet  
7 bearing the caption Program Logic Array Unit Sequence  
8 in Mnemonic Code. Can you find that sheet in the  
9 file in front of you?

10 and would you agree that the sheet bearing that  
11 designation that I read is in the file in front of you  
12 and is actually fastened in the file, is that correct?

13 A Yes.

14 Q And that appears in the file following copy  
15 of the letter of transmittal dated May 12, 1975, and  
16 there appears to be two copies of that letter in the  
17 file you have in front of you, is that correct?

18 A Yes, sir.

19 Q And they differ in that one has the dollar  
20 value \$117, that's been circled and initialled by  
21 somebody.

22 A Yes.

23 Q And that is the copy on the lefthand side  
of the file, and the copy on the righthand side of the

1 file does not have that circle and initials, does it?

2 A No.

3 Q Do you have any explanation for this, sir, as  
4 to why there should be two copies of that document in  
5 the file? Would it be correct, Mr. Hum, that the

6 MR. WELSH: I object to that question, and  
7 this line of questioning. You have what appears to be  
8 a certified copy of the file wrapper and contents as  
9 of the date it was furnished to you, Mr. Goldenberg,  
10 and obviously the file that was brought here by Mr.  
11 Tarring this morning is in different condition. It  
12 seems to me we are wasting time comparing the file  
13 that you have that was certified to be a true copy  
14 with the one that was brought here this morning.

15 MR. GOLDENBERG: I am not going to respond  
16 to that. I believe I am entitled to inquire into these  
17 matters. break and perhaps the witness would, also.

18 MR. TARRING: I don't want the examiner to  
19 become an interpreter of the file. If he has knowledge  
20 of why, fine, but I have been advising him not to  
21 guess. that a part of the application as filed?

22 MR. GOLDENBERG: I don't want him to guess.

23 MR. TARRING: If he knows why there's two there,



1 fina; if he doesn't, that is where it is going to have  
2 to end. For his opinion; to another extent, I think he's  
3 indicate MR. GOLDENBERG: I think that is correct. But  
4 I will withdraw the question.

5 Q Would it be correct, Mr. Hum, that the  
6 factual events that led you to call Mr. Katz and say  
7 that the Section 112 rejection would be withdrawn was  
8 that you found the program listing in the file?  
9 ask A: In part, yes. But with the breadth of the  
10 question What other element was involved, sir, or  
11 elements of fact? A: It lacks any foundation that he  
12 has any. The transmittal paper substantiated that  
13 fact. BY MR. GOLDENBERG:

14 Q Anything else? examiner you act on and were  
15 re: A: Not that I remember. On of the application,  
16 were you MR. GOLDENBERG: I would like to have a few  
17 minutes break and perhaps the witness would, also.

18 (Brief recess) f your duties to read or  
19 review BY MR. GOLDENBERG: filed?

20 Q Mr. Hum, with respect to the program listing,  
21 was that a part of the application as filed?

22 A MR. WELSH: Object to the question on the  
23 grounds it calls for his opinion. As you read the

1 MR. TARRING: I think I agree with counsel it  
 2 calls for his opinion; to another extent, I think he's  
 3 indicated as much if you would care to ask him about  
 4 the statement.

5 MR. WELSH: It also lacks a foundation.

6 MR. GOLDENBERG: I have the patent, and I  
 7 cannot tell; that is the reason I asked the witness.

8 MR. TARRING: What specifically are you  
 9 asking? I have difficulty with the breadth of the  
 10 question. Specifically, I direct your attention to

11 Page 5 of MR. WELSH: It lacks any foundation that he  
 12 has any knowledge, also. Sentence -- let me read the  
 13 first, and BY MR. GOLDENBERG:

14 Q Mr. Hum, as an examiner, you acted on and were  
 15 responsible for the examination of the application,  
 16 were you not? and a late date. However, the

17 for Answer Yes. The pending invention has just been

18 Q Is it a part of your duties to read or  
 19 review the application as filed? what that sentence

20 A Yes. Two sentences, right?

21 Q Did you do that in this case? and with the

22 A Yes. Expanding on the reason, after the

23 Q Do you recall at the time you read the

1 application did you read the program listing, and  
 2 this is the first time you read the application, sir.

3 A May I consult with counsel for a second?  
 4 originally presented, the so-called software listing.

Q Surely.

5 (The witness and Mr. Tarring consulted.)  
 6 quiring about, and I think you will agree with me that

7 A At the time of the examination, to the best  
 8 of my recollection, I recall the program listing.

9 Q I direct your attention to the office action,  
 10 which is Paper number 8 and bears on it mailed June  
 11 17, 1977. Specifically, I direct your attention to  
 12 question is there.

13 Page 5 of this office action, and the paragraph of  
 14 that page with the second sentence -- let me read the  
 15 first and second sentence.

16 "Regret is expressed for the inclusion of  
 17 the new grounds of rejection and objection found in  
 18 the new grounds. I would think there is perhaps an ex-  
 19 35 USC 112 at such a late date. However, the software  
 20 planation as to why there is, and I am going to use  
 21 for implementing the pending invention has just been  
 22 the work conflict for the moment. By that, I mean  
 23 received."

nothing perlocative at all. There is perhaps an  
 24 Could you explain, sir, what that sentence  
 25 explanation that could be made. I am seeking that  
 26 means or those two sentences mean?

27 MR. TARRING:- In a sense, I don't want him  
 28 explaining and expounding on the reasons which are  
 29 lacks a foundation if he has any recollection about  
 30 stated. Does this have relevance to --

31 that. I object to the question as calling for a

1 MR. GOLDENBERG: I think it has relevance.

2 MR. TARRING: I am wondering what it has  
3 relevance to, whether or not that was in the file as  
4 originally presented, the so-called software listing.

5 MR. GOLDENBERG: That is the matter I am in-  
6 quiring about, and I think you will agree with me that  
7 the second sentence indicating that the software  
8 for implementing the intended invention has just been  
9 received raises what, I think, is a legitimate question  
10 as to what is the fact of the matter. I think that  
11 question is there.

12 MR. WELSH: If he recalls.

13 MR. GOLDENBERG: I am talking to Mr. Tarring.  
14 My question is there because of later statements in  
15 the file, and Mr. Hum's testimony in connection with  
16 the matter. I would think there is perhaps an ex-  
17 planation as to why there is, and I am going to use  
18 the word conflict for the moment. By that, I mean  
19 nothing pejorative at all. There is perhaps an  
20 explanation that could be made. I am seeking that  
21 explanation or reconciling of this apparent statement.

22 MR. WELSH: I object to the question as it  
23 lacks a foundation if he has any recollection about  
that. I object to the question as calling for a

1 reason for a statement that he made, rather than  
2 calling for facts within his recollection.

3 MR. GOLDENBERG: My present question doesn't  
4 at all go to reasoning. I am asking for an explanation  
5 of the statement.

6 MR. WELSH: It is calling for his opinion now  
7 as to the basis for the conflict, and I think it is  
8 wholly improper. It is not based on recollection.

9 MR. GOLDENBERG: If there is any doubt on  
10 that score, my question goes to at the time of the  
11 statement, at the time the statement was made, not now.

12 MR. WELSH: Your question asked what does that  
13 statement mean.

14 MR. TARRING: Insofar as there appears to be  
15 perhaps a little bit of confusion on this point, I  
16 think I will let <sup>him</sup> answer it. I want it understood,  
17 however, I don't want the examiner being used to in-  
18 terpret statements in the file wrapper. As a general  
19 rule, it is inappropriate.

20 MR. GOLDENBERG: I appreciate your position  
21 on that, sir.

22 Q If you can answer the question, I would  
23 appreciate it.

1 MR. WELSH: Could we have the question  
2 again. There has been a lot of colloquy.

3 A MR. GOLDENBERG: I will restate the question.

4 Q BY MR. GOLDENBERG:  
5 whereQ Do you recall now what you intended by that  
6 statement which appears in the second sentence of the  
7 last paragraph on Page 5 of the office action.

8 A MR. TARRING: Could I suggest, instead of  
9 asking what he intended, if you ask upon what facts  
10 that statement was based or what the situation was at  
11 that time when that statement got into the record, as  
12 best he recalls?

13 Q I accept that, and if you could tell me, sir,  
14 upon what facts did you rely when you made that  
15 statement?  
16 available Upon review of the preceding amendment, the  
17 software listed, I was under the impression the soft-  
18 ware listed was submitted with the preceding amendment,  
19 but I had recalled the fact that I looked at the  
20 listing before. I was apparently mistaken of where  
21 or when the listing actually came in, and further  
22 reference to the telephone interview that we had  
23 discussed earlier.

1     sir, Q     This is the telephone interview with Mr.  
2     Katz?

3     A     Yes.

4     Q     Is it the first or second one -- the one  
5     where you called him back?

6     A     Yes.

7     now? Q     That was the second telephone interview?

8     A     Yes. I explained to him at that point.

9     Q     With respect to this software listing that you  
10    say you had found in the file and called Mr. Katz,  
11    how many pages did it have, sir?

12    A     I don't remember the number of pages.

13    Q     I have here a document which appears under  
14    the seal of the Patent Office statement, this is to  
15    certify that the annexed is a true copy from the  
16    available microfilm records of this office of the  
17    application as originally filed May 13, 1975, Serial  
18    No. 576980, entitled Player operated game apparatus.

19    I direct your attention to the latter part  
20    of that document, which includes copy of the paper  
21    that we referred to earlier, namely the one captioned  
22    Program Logic Array Unit in Minomic Code, and one sheet  
23    of what is apparently a program listing. I ask you,



1 sir, with that in front of you, does that refresh your  
2 recollection as to the size or extent of the program  
3 listing that you originally read with the application  
4 as filed?

5 A The size, yes.

6 Q Could you tell me what your recollection is  
7 now?

8 A It would be advancing an opinion, but the  
9 program was longer than that.

10 Q It was longer than that?

11 A Yes.

12 Q Is it your present belief that the one that  
13 was with the application as filed?

14 MR. TARRING: Would you specify what you  
15 mean by that is the one?

16 Q The longer one that you are referring to.

17 A Yes.

18 Q Is it your testimony then, referring again  
19 to this second sentence indicating that the software  
20 ~~has~~ <sup>had</sup> just been recieved, that you were in error when  
21 you made that statement in the office action?

22 A Yes.

23 MR. WELSH: While we have this document out,

1 I would like to request it be marked as an exhibit.

2 MR. GOLDENBERG: I would like this document  
3 that we have referred to just a moment ago marked for  
4 identification as Defendant Williams Deposition Exhibit  
5 No. 1, and we will furnish copies.

6 (The document referred to was  
7 had earlier in the history of the case, Williams Deposition  
8 marked Williams Deposition  
9 Exhibit No. 1 for identification.)

10 Q Mr. Hum, directing your attention to the inter-  
11 view with Mr. Katz on June 14, 1977 at which you dis-  
12 cussed with him the exclusion of pinball elements in  
13 the claims, we were asking questions about that earlier  
14 this morning, do you recall? If I have misstated, sir,  
15 please correct me.

16 Q We did not discuss exclusion.

17 Q You discussed inclusion of pinball elements  
18 in the claims.

19 A Yes.

20 Q Did you say to Mr. Katz if such elements were  
21 included you would allow the claims?

22 A I don't remember specifically.

23 Q Did you say anything suggesting or indicating  
to him that you would more than likely allow the claims

1 if such elements were included?

2 1:7 A: I believe so.

3 spec Q: Did this then lead to the discussion wherein  
4 this language of moving mass was agreed upon?

5 A: I believe so.

6 your Q: I believe it was your testimony, sir, that you  
7 had earlier in the history of the application suggested  
8 that if limitation as to pinball machines were inserted  
9 in the claims you would consider them allowable, is  
10 that correct?

11 MR. WELSH: I object to the question. You  
12 are characterizing his testimony. Ding question.

13 MR. GOLDENBERG: If I am characterizing it  
14 incorrectly, Mr. Hum can correct me. Will ask another

15 question. MR. TARRING: I don't recall that part of  
16 the testimony, either.

17 MR. GOLDENBERG: My notes tell me that, and  
18 I am attempting to resolve the matter, but the record  
19 will show. We could have the reporter find it, but  
20 we will not do that.

21 Q According to your recollection whether you  
22 had in some previous occasion in acting upon the  
23 application, my attention has been directed to the

11 first office action which was mailed on February 26,  
2 1976, and is Paper number two in the application, and  
3 specifically the last page of page four of that office  
4 action. I would ask you to read the paragraph that  
5 number five there, and then tell me whether or not  
6 your recollection was refreshed with respect to the  
7 outstanding question.

8 A Yes.

9 Q Could you now answer the question, sir?

10 MR. WELSH: What question is outstanding?

11 MR. TARRING: Could we have the question read  
12 back. I think there is an outstanding question.

13 MR. GOLDENBERG: There is an outstanding ques-  
14 tion, but I will withdraw it and I will ask another  
15 question.

16 Q Having looked at the document, sir, isn't it  
17 a fact that you had earlier suggested to the applicant  
18 that if limitations directed to a pinball machine were  
19 included in the claims, then the claims could be  
20 allowed, is that correct?

21 MR. TARRING: Right here, I think we are  
22 getting into an area where we are interpreting the file  
23 wrapper to a large extent. I think the file wrapper

1 speaks for itself.

2 MR. LYNCH: Mr. Tarring let me say one thing.  
3 People are always saying documents speak for themselves,  
4 and I have never heard a document speak no matter how  
5 close I get my ear to it. Mr. Hum is the person who  
6 generated these documents. This is a document that is  
7 an open file, and insofar as Mr. Hum is setting forth  
8 a position of the Patent Office in writing to the  
9 applicant saying the claims would be allowable given  
10 X, Y and Z, it seems to me the examiner is entitled  
11 to pursue, not how he came out there, not his mental  
12 processes for coming out there, but certainly to say  
13 this was the Patent Office's position at this time, and  
14 to take the comment out of the jargon of the Patent  
15 Office and place it into context that a judge will  
16 understand, and consequently, if we ask Mr. Hum what's  
17 the position of the Patent Office at that time as  
18 reflected by his comment, I don't think we are asking  
19 for his mental process. We are asking for the outcome,  
20 his final position as of this time, and then we may ask  
21 how that final position evolved or changed as the  
22 examination procedure continued. I fully appreciate  
23 that drawing the line between mental process and non-

1 mental process is difficult, even recollection is a  
2 mental process.

3 In this instance, I think we are entitled to  
4 say when the examiner says if applicant claims one to  
5 a pinball machine, this is a Patent Office position as  
6 to the patentability at this juncture, and it seems to  
7 me we are entitled to examine him about this Patent  
8 Office position to articulate and make it clear.

9 MR. TARRING: My problem really is where we had  
10 a problem in making clear what the record said, we went  
11 a little bit beyond where we normally would. I can't  
12 see how a judge could misinterpret the written word.  
13 I don't see where there is a problem with a judge  
14 understanding that, and your articulating it five or  
15 six different ways wouldn't make it any clearer.

16 MR. WELSH: I agree with Mr. Tarring. I  
17 believe your question is calling for interpretation  
18 of the document, and that is not a proper question for  
19 this witness.

20 MR. TARRING: I tell you what; if you want to  
21 ask Mr. Hum factually, besides this document, if he  
22 communicated by telephone, personal interviews, whatever  
23 with the applicant, a position, as you indicate, okay.



1 question. However, if we are going right back to this  
2 document and what it says, as being the communication  
3 which you are referring to, we are really interpreting  
4 a perfectly clear document. very well may be. I am

5 stating MR. LYNCH: I think we are entitled to ask  
6 Mr. Hum did the Patent Office have a position at this  
7 time about the allowability of this claim, what was  
8 that position, and you can look at this document to  
9 refresh your recollection. It is an entirely appro-  
10 priate question, and this idea that documents speak  
11 for themselves would eliminate exhibits from depositions.  
12 All you would do is let the reporter annex them, and  
13 let them speak or copy them down. We cannot do that.  
14 So it seems entirely appropriate to ask what was the  
15 Patent Office's position at this juncture. that at the  
16 time of MR. WELSH: That was not the question.

17 position? MR. TARRING: I think even there, that is  
18 calling for the examiner to provide an interpretation  
19 of the file wrapper. BNG: At the subsequent interview

20 on June 1 MR. GOLDENBERG: That was put there solely to  
21 refresh his recollection; that was the sole purpose  
22 for which it was offered. a pinball machine were

23 inserted, MR. WELSH: I think you have to look at it



1 question by question. What Mr. Lynch is interpreting  
2 the question to be, I believe is not quite what the  
3 question is.

4 MR. LYNCH: That very well may be. I am  
5 stating the position that we are entitled to get. My  
6 turn is coming, and I realize this is a very difficult  
7 area.

8 MR. GOLDENBERG: Can we have an understanding  
9 that the document that we are all presently looking  
10 at and that last paragraph states the Patent Office's  
11 position at that time?

12 MR. TARRING: It's a signed Patent Office  
13 communication at the time, I don't see where there  
14 could be any problem with that.

15 MR. GOLDENBERG: You would agree that at the  
16 time of the document that was the Patent Office's  
17 position?

18 MR. TARRING: Yes.

19 MR. GOLDENBERG: At the subsequent interview  
20 on June 14, 1977, again, can it be agreed that Mr. Hum  
21 was stating the Patent Office's position, namely, that  
22 if limitations directed to a pinball machine were  
23 inserted, then the claims would be allowed?

1 MR. TARRING: I simply don't recall that  
2 testimony.

3 MR. WELSH: I don't recall those words. He  
4 said nothing about it being allowed. The record will  
5 speak for itself, and this is your characterization  
6 of his testimony and asking for an interpretation from  
7 Mr. Tarring, I think is completely inappropriate. He  
8 is not a party to the lawsuit.

9 MR. GOLDENBERG: We are doing no more than  
10 attempting to find out what happened during the  
11 prosecution of this application.

12 MR. TARRING: Insofar as what the facts of  
13 what occurred are concerned, you are welcome to them.  
14 Where we start interpreting the file wrapper, I have  
15 trouble with that.

16 Q Let me ask this question, Mr. Hum, there was  
17 conversation between you and Mr. Katz about the in-  
18 clusion in the claims of limitations directed to a  
19 pinball machine, that is true, isn't it, sir?

20 MR. WELSH: I object to the question.

21 MR. GOLDENBERG: We are talking about the  
22 interview of June 14, 1977, when Mr. Katz was in your  
23 office.

1 A I don't remember whether or not I mentioned  
2 pinball limitations or pinball type limitations.

3 Q What distinctions do you draw between pinball  
4 limitations and pinball type limitations?

5 MR. TARRING: I don't think we are here to get  
6 what distinctions he's drawn. We are here to get what  
7 was discussed. We are here to get what factually  
8 was communicated between the two, not the distinctions.

9 directed MR. GOLDENBERG: I am only interested in the  
10 distinction he is drawing at this time in connection  
11 with the answer he just gave, that is all. I assure  
12 you my question is not intended to inquire into the  
13 state of his mind at the time of the interview.

14 as Q I direct your attention again to the amendment  
15 D, which I believe is Paper number eleven in that file,  
16 and Page 18 particularly, and the paragraph starting  
17 however. I ask you to read that paragraph, sir, and  
18 then tell me whether or not it refreshes your recollec-  
19 tion as to whether there was any discussion with Mr.  
20 Katz about putting limitations in the claims about the  
21 pinball machine or relating the claims to a pinball  
22 game?

23 A MR. WELSH: I object to the question as being

1 stated in the alternative, and including more than  
2 one question.

3 Q Can you answer the question, sir?

4 A Would you repeat the question?

5 on Q Let me withdraw it and restate it.

6 A Upon reading that paragraph, is your recollec-  
7 tion refreshed as to whether there was any discussion  
8 about amending the claims to include limitations  
9 directed to a pinball game?

10 in A No. I don't remember.

11 Q You did earlier, I would like the reporter to  
12 go back and give your earlier testimony.

13 You really, at this time have no recollection  
14 as to whther there was any discussion? topic?

15 A Not to your specific question.

16 Q Was there any discussion in any way connected  
17 with amending the claims to put in limitations directed  
18 in some way to a pinball game, and this is at the inter-  
19 view of June 14, 1977 with Mr. Katz?

20 MR. WELSH: Your previous question was  
21 referring to an October 17 amendment, and now you are  
22 referring back.

23 A I don't recall with respect to the specifics

of the question.

Q Could you tell me what specifics?

A Could you repeat the question again?

Q You do recall the interview with Mr. Katz on June 14th?

A Yes.

Q Do you recall whether or not on the occasion of that interview you had any discussion with Mr. Katz about amending the claims to insert limitations directed in some way to a pinball game?

A I don't recall if we discussed limitations directed to a pinball game.

Q Do you recall what you discussed about anything sounding like that or relating to that topic?

A Possibly sounding like that.

Q Don't you recall telling me about reaching an agreement on the language, or the phrase, moving mass?

A Yes.

Q Don't you recall that you told me earlier the reason you reached agreement on this phrase is that Mr. Katz and you discussed some kind of game where there was a vertical motion of some kind as opposed to the horizontal motion of pinball games?

A Yes. It will come back to you. In the meantime, MR. TARRING: That was the reason and that is what bothers me. mention to the first office action in this appeal. MR. WELSH: I object to covering the same ground, we covered before. If applicant includes and claims on MR. GOLDENBERG: There is confusion on the matter, Mr. Welsh, and I regret, it just as much as you do, but I think the matter should be made as clear as we can for the court, that's all. and if the information port. Q. Did you say to Mr. Katz, on the occasion of that interview, if limitations directed to pinball games were inserted in the claims that you would consider them favorably from the point of view of allowing them? was the actual basis for that statement? A. May I confer with counsel?

Q Please. I have difficulty interpreting that, and MR. WELSH: I object to the question as mischaracterizing the previous testimony of the witness, actually trying to put words in his mouth.

A With respect to your question, it would require interpretation on my part of language that you used, and I just don't remember specific events with respect to your specific question.

1 Q Perhaps it will come back to you. In the  
2 meantime, let me ask you this question, here again, I  
3 direct your attention to the first office action in  
4 this application, the one dated February 26, 1976 on  
5 Page 4, and this paragraph; If applicant includes and  
6 claims one and twelve limitations directed to a pinball  
7 machine and associated elements, eg. player operated  
8 flipper means, ball means, and projector means, etc.  
9 correlated to claimed structure, and if the indefinite  
10 portions are clarified, then claims would appear  
11 allowable.

12 Q Have you read the sentence, sir?

13 A Yes, I have read the sentence.

14 Q What was the factual basis for that state-  
15 ment at the time it was made?

16 MR. TARRING: I have difficulty interpreting  
17 that, and I am sure he does to. I am not sure he  
18 knows what you are asking for. Do you understand  
19 the question?

20 THE WITNESS: Not unless he is referring  
21 to the decision making process.

22 Q What facts did you know at that time that led  
23 you to make that statement to the applicant?

recessed until 1:15 p.m.)



1 MR. TARRING: I am going to direct him not  
2 to answer that. It is going into mental processes  
3 and calling for interpretation of facts that are un-  
4 specified. It is too broad, and I don't think he  
5 understands it.

6 MR. GOLDENBERG: Do you advise the witness  
7 not to answer the question?

8 A I don't think I can give you a date.

9 MR. TARRING: Yes.

10 Q Do you recall anything that you said to Mr.  
11 Mr. Hum, at the time you made that statement,  
12 that Mr. Vatz said to you during the next interview  
13 sir, did you know that pinball games were old?  
14 that occurred?

15 A Yes.

16 MR. WELSH: I object. There's been no  
17 Q Did you know that microprocessors were old  
18 foundation laid.  
19 and in the prior art at the time you made that  
20 statement? Was there more than one interview, sir?

21 A I don't remember.

22 MR. WELSH: I object to the question as  
23 You don't remember if there was more than one?  
indefinite as to what is meant by prior art, and

24 A No, I don't.  
25 calls for his opinion.

26 Q Let me direct your attention to a paper  
27 MR. GOLDENBERG: I am referring to prior art  
28 captioned Supplemental Amendment, and bears date stamp  
29 in the Patent Office.

30 of being received November 18, 1977, and I think it is  
31 Q Did you know, at the time you made your state-  
32 ment that microprocessors were in the prior art?  
33 Paper number 13. I direct your attention to Page 5  
of that amendment, and the first sentence under remark

34 A Yes.

35 I direct your attention to that, and I would ask you  
36 (Whereupon, at 12:15, the deposition was  
37 if that refreshed your recollection as to whether or not  
38 recessed until 1:15 p.m.)

there was an AFTERNOON SESSION (1:15 p.m.)

14, 1977? BY MR. GOLDENBERG:

Q Following the interview that we were inquiring about this morning, that is the one that occurred on June 14, 1977, what is the next interview that you remember?

A I don't think I can give you a date.

Q Do you recall anything that you said to Mr. Katz or Mr. Katz said to you during the next interview that occurred?

Q MR. WELSH: I object. There's been no foundation laid. said by you or by Mr. Katz on the

occasion. Was there more than one interview, sir?

A I don't remember. the question chronologically

Q You don't remember if there was more than one?

A No, I don't.

Q Let me direct your attention to a paper that captioned Supplemental Amendment, and bears date stamp of being received November 18, 1977, and I think it is Paper number 13. I direct your attention to Page 5 of that amendment, and the first sentence under remarks. I direct your attention to that, and I would ask you if that refreshes your recollection as to whether or not

there was an interview after the interview of June 14, 1977?

A Yes, to some extent.

Q Do you have any recollection, sir, as to what was said at that interview, either by you or by Mr. Katz?

A To a certain extent, yes.

Q Do you now recall that there was an interview on or about that date?

A Yes.

Q Could you tell me, to the best of your recollection what was said by you or by Mr. Katz on the occasion of that interview?

A I won't address the question chronologically because I don't remember the order in which it came up.

Q Understood.

A I believe I brought up a new reference that I found. It is noted on Page 5, Patent number 402655. I believe we discussed the subject matter there. I don't remember what transpired specifically with respect to this reference.

A I vaguely remember discussing the subject matter referred to in the last paragraph on Page 5 of

Amendment 13.

Q I think it is Paper 13.

A All right, Paper 13. I remember discussing certain information, certain formal matters with respect to the claims, but as to the specifics of this interview, I can't remember.

Q Do you recall what you said to Mr. Katz about this additional reference, Patent No. 402655?

A I can't remember.

Q Do you recall what Mr. Katz said to you about it?

A No, I don't.

Q Directing your attention to Page 6 and the next to the last paragraph in which you are reported as saying, if you note any other matters requiring formal amendment, you would call the undersigned attorney. Did you make any such telephone call?

A May I refer to the file wrapper?

Q Please do.

A I don't remember.

Q You don't remember whether you did or not?

A Correct.

Q Do you remember any interview or interviews

that took place after the interview in November?

A: Yes. You mean --

Q In connection with this application.

A I refer to this paper, this is November?

Q: Yes, and that refers to a November interview.

My question to you: do you remember any interview or interviews taking place after the November interview?

A: I don't remember. There has been more

than one. I would like you to turn to a paper captioned

Amendment 7 CFR, Section 1.312 which was apparently

filed in the Patent Office on February 2. You have

that paper in front of you now, February 2?

A: Yes. Is paper number 2? Do you have any

recollection I direct your attention to Page 2 of that

paper, and the first paragraph of that page, and would

ask you to read that paragraph.

A Do you now remember any interview or interviews after the November interview?

A: Vaguely, yes.

Q Do you recall whether that interview was conducted over more than one day?

A: No, I don't.

Q You note in the paragraph that I called to

your attention that, do you have any reason to believe that is not true? I don't specifically remember.

A No, you read the Bally Service Manual during the course. Do you remember who was in attendance at that interview? the course of the interview?

A I believe it was just Mr. Katz.

Q Have you ever had any interviews in connection with this application in which there has been more than one person in attendance representing the applicant? are those portions to which your attention was directed? I don't think so, but I am not certain.

Q Let's focus in on the interview record on Page 2 of this paper, number 18. Do you have any recollection, at this time, of what was said to you by Mr. Katz or what you said to him in the course of the interview? you identify or recall at this time which portion? Vaguely. I read?

Q Could you give me the extent of that recollection, sir? view.

A I vaguely remember discussing the Bally Alley Service Manual referred to in this Page 2 of this Paper number 18.

Q Do you remember what was said by yourself or

by Mr. Katz during that discussion? yes.

A No, I don't specifically remember.

Q Did you read the Bally Service Manual during the course of that interview?

A During the course of the interview?

Q Yes. you don't remember what the reason was?

A Not at full length. this occurred with respect to Did you read portions of it? bound by

35 Q I believe I did.

Q Were those portions to which your attention was directed by Mr. Katz? or applications, is that it?

A I don't remember.

Q Is the Bally Alley service Manual in that file you have in front of you? had issued?

A Yes. not certain if it had been printed at that time. Could you identify or recall at this time which portions you read?

A I don't remember what portions I read during that interview. you what the Bally Alley game was?

Q Did you read the Bally Alley service manual at any other time? review you referred to in Paper No. 10 taxi A Yes. according to the paper, on January 24, 25

Q When did you do that?



A I can't give you specific dates.

Q Was it after the patent issued?

A Oh, yes.

Q What led you to read it?

A I am afraid I can't answer that question.

Q Is it you don't remember what the reason was?

A Well, the reading of this occurred with respect to another application. I am bound by 35 USC 122 not to answer.

Q You read it in connection with the examination of some other application or applications, is that it?

A Yes.

Q At the time, if I understood your testimony, that was after Patent 4093232 had issued?

A I am not certain if it had been printed at that time, but to the best of my recollection, after it had gone beyond my jurisdiction.

Q At the time of the interview, sir, did Mr. Katz explain to you what the Bally Alley game was?

A You mean the immediate interview?

Q This interview you referred to in Paper No. 18 taking place, according to the paper, on January 24, 25

A I don't remember.

Q Did he explain or state to you that the Bally Alley game was controlled by a microprocessor?

A I don't remember.

Q Did Mr. Katz say anything to you about the game, its construction or mode of operation, other than what appears in the Bally Alley Manual?

A I don't remember.

Q Did he tell you the microprocessor in that game was an Intel 4004 microprocessor?

A I don't remember.

Q Did he tell you that the lamps constituting part of that game were connected in a matrix?

A I don't remember.

Q In the course of that interview, did you come to understand the game Bally Alley?

MR. WELSH: Object to the question as calling for a mental process.

MR. TARRING: I think that is calling for a conclusion.

MR. LYNCH: I think understanding the operation of a device is a fact.

MR. GOLDENBERG: Whether or not he understood it, sir. I am not going into his mental process. I

am not going into why he did what he did. I am attempting to ascertain the extent of the witness's knowledge and time of a specific event.

MR. TARRING: Why not just ask him if he reviewed it at that time. interview.

MR. LYNCH: Insofar as anything is a mental process, then everything gets processed through the mind and recollection, and everything else, but it is a fact as to whether the examiner at one time or another had a thorough understanding of circuit operations. That is all I am talking about here. I would encourage you to reflect on that.

MR. WELSH: I would like to point out that is clearly within the protection of the protective order in calling for the basis of mental processes or conclusions of the examiner acting upon an application.

referred MR. LYNCH: May I make one other statement for the record. Communications were had with the examiner and they are reflected in this file. It seems to me entirely appropriate to inquire whether there was an understanding of the operation of an electrical device. To limit the testimony, to forbid an inquiry as to whether there was an understanding of

of circuit operations is really to absolutely prohibit any knowledge as to whether there was an appreciation of the teaching of the references.

MR. WELSH: That goes to the mental process and not what went on in the interview.

MR. TARRING: I tend to think the whole focus is a little bit askew, how well he understood this or understood that, the fact is the patent is issued and whether the patent is something that was properly or improperly issued is something that will stand on its own two feet, and not a rehash of the examiner's understanding.

MR. GOLDENBERG: That doesn't quite do it really, because there are certain presumptions when the Patent Office issues a patent. You know that as well as I do, and that is the law, and indeed you referred to that in your opening statement here. I think we are entitled to explore, by discovery, as to whether or not those presumptions should have any vitality to them. At this point, I don't know whether they do or not, and that is all we are inquiring into, and the questions are factual questions. The mental reasoning of Mr. Hum is not a thing that we are

inquiring about. We are inquiring into his understanding of something that was represented to him by the attorney for the applicant as prior art, and that is all we are doing. I think this matter was brought to fix.

MR. WELSH: That is synonymous for mental process. It is entirely appropriate to ask Mr. Hum what his understanding is.

MR. GOLDENBERG: You know there are various ways of dealing with presumptions. This is, of course, after the fact.

MR. LYNCH: If you would consider the fact that this is a situation where a piece of art is not presented to Mr. Hum, he didn't come across it himself. It was presented to Mr. Hum at an interview. We have a situation where this has now been placed on the face of the patent, and there is a presumption that may or may not be, but let's assume the patentee to be relied upon to take the position of presumption of validity of the patent over that reference.

Now it seems to me that any legitimate inquiry which goes to the understanding of that, the fact of that understanding, goes to the matter that is involved in the prosecution. But insofar as how does

MR. WELSH: You are seeking to make the witness an expert to give you his understanding of

what, as a person skilled in electronics, of what the operation of the Bally Alley is, and that would call for another objection. Is basically what is being in-

MR. LYNCH: I think this matter was brought to Examiner Hum's attention by the patentee. It seems to me it is entirely appropriate to ask Mr. Hum what his understanding was of the applicability or operation of that particular circuit. And this is, of course, after the notice of allowance had been set out, and the item was made a matter of record in the Patent Office. Were any representations made to you by Mr.

MR. TARRING: I will let you inquire as to the extent of the study of the device. As far as the remainder of it goes, I am not going into a situation where we are going to talk about this and that element, how does it work, and not going to discuss a Bally Alley examination. Katz say anything to you, sir, about

As far as the examiner is concerned, you know his background, it's been established, and it is presumed he is competent. To the extent that he looked at that thing, that is okay, but insofar as how does this work, how does that work, that is entirely disruptive of the executive process in this area. I



cannot imagine a judge standing for his being questioned as to what he understands of this or that.

I think that is basically what is being inquired into. As far as what physically happened, as far as the extent of his study, fine, but I don't go for it beyond that.

MR. GOLDENBERG: I take it you are advising the witness not to answer the question.

MR. TARRING: Not in the broad sense.

BY MR. GOLDENBERG:

Q Were any representations made to you by Mr. Katz about the operation of the Bally Alley game?

MR. WELSH: I object to the question. You have already asked the question, and he said he didn't recall how Bally Alley works.

A I don't remember.

Q Did Mr. Katz say anything to you, sir, about the Bally Alley game including a number of lamps connected in a matrix and the lamps were controlled by multiplexing?

A I don't remember.

Q Do you recall whether he said anything to you about how the digit displays were connected to the



microprocessor?

A No, I don't remember.

Q Do you recall whether or not you knew, at that time, there was a microprocessor controlling

the game?

A I don't remember, not at that time.

A I believe I did.

Q Did you later acquire such knowledge?

A Where are those notes?

A Yes.

A I no longer have them in my possession.

Q What was the source of that knowledge?

Q Do you know where they are?

A I have to invoke 35 USC 122.

A No, I don't. I generally take handwritten

Q This is because this was in connection with notes during the interview, after I allow the case, some other application?

I generally destroy the pencil notes.

A Correct.

Q Do you believe you did that in this case?

Q Did you acquire that knowledge from studying

the service manual?

Q Are you familiar with any Patent Office

A Yes.

practice or procedure with respect to examiners

Q From that study of the manual, were you able recording what takes place at interviews?

to identify the microprocessor that was involved on

this later study?

Q Did you follow that practice?

MR. TARRING: Wait a minute. We are talking

about something that is occurring in another appli-

cation. I don't think that is appropriate.

MR. GOLDENBERG: I will withdraw the question.

Q Did Mr. Katz, at the time of that interview, say anything to you that the lamps constituting a part of the game were turned on and off rapidly so as to eliminate flicker?

A I don't remember.

Q Did you make any notes of that interview, sir?

A I believe I did.

Q Where are those notes?

A I no longer have them in my possession.

Q Do you know where they are?

A No, I don't. I generally make handwritten notes during the interview, after I allow the case, I generally destroy the pencil notes.

Q Do you believe you did that in this case?

A Yes.

Q Are you familiar with any Patent Office practice or procedure with respect to examiners recording what takes place at interviews?

A Yes.

Q Did you follow that practice?

A At the time I followed the office policy, yes.

Q Did this office policy, at the time of any of these interviews, require that if there was an agreement

reached, the recordings of those interviews should be signed by the attorney and examiner?

A Could I confer with counsel?

Q Surely.

A Could you read that back?

(Question read back)

MR. WELSH: Object to the question, the original question was with respect to that interview regarding Bally Alley. Now your question calls for any of those interviews. I think your question is indefinite. What do you mean by any of these interviews?

Q Can you answer the question, sir?

A As far as office policy is concerned, I don't think we are required, if the record was complete in our determination.

Q And you did not do it in this case?

A No.

Q But it was a suggested procedure, was it not, during the period you were acting on this application?

MR. WELSH: That is if an agreement were reached? I object to the question, it is indefinite as far as what is meant by that accepted practice.

MR. GOLDENBERG: I withdraw the question.

Q In the course of the past few moments, since we have been discussing this interview conducted apparently on two days, January 24, 25, have you had any additional recollections about what was said or done at that interview, sir?

A No, I haven't.

Q Did you, in the course of any search that you made while acting on the application we have been inquiring about, make any searches into the technical literature as distinguished from searches into Patent Office sub-classes of prior arts?

A I am not certain what you are asking. May I explain my answer?

Q Please do.

A Our files are set up so that we have some technical literature in the shoes, but from time to time, we also can search in a scientific library for technical literature. I don't know what you mean by searching for technical literature.

Q Did you, in this instance, search in the scientific library of the Patent and Trademark Office?

A No, I didn't.

Q The word shoe that you used earlier, can we

agree that is a file drawer in a stack of file drawers as used in the Patent Office?

A Yes.

Q I notice in the patent, column eight, bottom of the column, there is a reference to an Intel NCS-40 Users Manual for Logic Designers. Did you consider the contents of that document during the course of your examination of the application for the patent that ensued?

A I don't believe so.

Q Did you consider the contents of any publication or document issued by Intel Corporation, in connection with the operation of the 4004 micro-processor?

MR. WELSH: At what time?

Q In the course of your examination of the application for the patent that ensued, did you consider any publication or document issued by the Intel Corporation which related to the M 4004 microprocessor or its use?

A I don't believe so.

Q How sure are you of that answer, sir; are you reasonably sure?

A Reasonably sure.

MR. GOLDENBERG: I have no further questions.

EXAMINATION IN BEHALF OF D. GOTTLIEB & CO.

BY MR. LYNCH:

Q Just one matter, you did receive a subpoena to appear here, did you not?

A Yes.

Q Did you receive one from both Williams and Gottlieb?

A I received two. I didn't look at the names.

Q I believe the record will reflect that one was served by defendant Williams and one was served by defendant Gottlieb. I believe that was the area my office consulted with Mr. Tarring.

MR. TARRING: Your office called with respect to that, and your office called before that, as I will indicate exactly where he searched.

Q MR. WELSH: We haven't seen copies of the subpoena.

A MR. TARRING: I am perfectly willing to talk with anybody about what our responses will be at a deposition. If you would, Mr. Hum, to refresh your recollection.

Q You were served with two subpoenas?

A Yes. TARRING: I will advise the examiner he can ask you received the patent application and the patent ensued. I believe you stated you read it, self, and then what did you do in connection with your self, examination? to be a redundancy in spades.

A Made a search of the prior art. TARRING: When you made a search of the prior art, what were you looking for? what references he found that refer MR. WELSH: Object to the question as calling for his mental process and analysis of the application to determine what subject matter he was going to seek to search. I think it is a completely improper any question. to use of a microprocessor in a pinball machine? MR. TARRING: I agree it is designed to reflect upon his analysis of the case. I would point out that the patent file, as a normal course of events, will indicate exactly where he searched. which are or Q I asked what he was looking for. What did you find?, I think it speaks for itself.

A I found prior art. TARRING: What did you find with respect to pinball machines? If you would, Mr. Hum, to refresh your recollection, you can look at the first office action.



1 improper MR. TARRING: I will advise the examiner he  
 2 can answer if he recalls things that he found that are  
 3 not already indicated within the file wrapper itself.  
 4 Insofar as what is clearly in the file wrapper itself,  
 5 that seems to be a redundancy in spades. for by way

6 of prior MR. WELSH: I object to the question also,  
 7 what is meant by what did he find. therefore, I object  
 8 to this I am talking about what references he found  
 9 that referred to pinball machines that related to the  
 0 subject matter of this application. indicated in the art

1 of record I believe I noted that in the prior art.  
 2 records. It's a fact, Mr. Hum, you didn't find any  
 3 reference to use of a microprocessor in a pinball  
 4 machine? an what is the reference in the art of record

5 that reference MR. TARRING: Just a minute. Here again, by  
 6 forming a question in a particular manner, we are trying  
 7 to get the examiner to characterize things which are  
 8 or are not in the record. As far as the record is  
 9 concerned, I think it speaks for itself. I shall allow

10 to call MR. LYNCH: I am not talking about the record.  
 11 I am talking about whether he found a reference to  
 12 microprocessors  
 13 microprocess being used in a pinball machine? reference

14 the proper MR. WELSH: I object to the question as

improper. By the use of the word find, you imply that he was looking for something, and that is improper because it requires, or inquires into his analysis of the application to determine what he considered to be the invention, what he was looking for by way of prior art, and to ask him what he found implies that he was looking for something, therefore, I object to this question. things I wasn't looking for.

MR. TARRING: I would suggest you ask if he found anything other than what is indicated in the art of record in the way of pinball machines that he recalls references referring to microprocessors used for MR. LYNCH: I can ask if he found anything other than what is reflected in the art of record that referred to the use of microprocessors in a pinball machine? I can ask him that?

A MR. WELSH: If he recalls.

MR. TARRING: Do you understand the question?

MR. WELSH: Before he answers, I would like to call attention to a list of questions which were in the deposition that involved going before the court here in the District Court of Virginia to determine the propriety of these questions, and one of them

that was found to be improper, did you look for such a reference. If you repeat the question, please?

Q MR. LYNCH: I am asking him what he found.  
reference MR. WELSH: To find something, you have to be looking for it. It is implicit in the question did you find something, what were you looking for. In a pinball machine MR. LYNCH: I think that is a nonsequitur; I found a lot of things I wasn't looking for.

Q MR. TARRING: I think that underlies a lot of the problem with this line of questioning.

A MR. LYNCH: It was indicated, I think, if he found any references referring to microprocessors used for operating pinball machines other than those cited. Are you now aware of whether computer operated

arcade game MR. TARRING: To the extent she recalls. the  
date Q To the extent you recall, it was filed?

A Can I refer to the file? difficulty with  
that Q Yes, is completely beyond the scope of the

examination MR. TARRING: Could I ask if there is more than one 892, that is the list of references? is action

Reference Q I am talking about the first search. I am talking about the beginning. I asked what he did, he said he searched the art. In connection with that

first search, that is all I am talking about.

A Could you repeat the question, please?

Q Did you uncover a reference, other than the references set forth in this notice of references dated 12-15-75, in the initial search on this application which related to a microprocessor in a pin-ball machine?

A No.

Q Did you find references that related to microprocessor controlled arcade games generally?

A In this search? your handwriting?

Q Yes.

A No, not on this search.

Q Are you now aware of whether computer operated arcade games were in the prior art as of the time the patent application of the patent suit was filed?

with your MR. TARRING: I have some difficulty with that. That is completely beyond the scope of the examination of this case.

MR. LYNCH: There is a comment in this action. Reference R, Page 4, right before this note, there is an indication reference R teaches the well-known fact that computerized games are old. Number 6 on Page 5

of the office action dated February 26, 1976.

Q At the time you made this search, Mr. Hum, were you aware that microcomputer operated games were in the prior art?

A No.

Q In the file wrapper, on the inner cover, and not appearing on any -- I guess it probably does that appear or perhaps appears -- but on the inner cover above the printed word search, there is a notation consulted Stewart in Class CL 179-15 on time dif mux. Did you make that note in your handwriting?

A Yes.

Q What does that note mean?

A I consulted with Mr. Stewart in Class 179, sub-class 15 on time division multiplexing.

Q Do you remember if that was in connection with your original search?

A Yes.

Q What did you find about time division multiplexing in your discussions with Mr. Stewart. I want to know what facts he was told. I don't want to know what his discussion was. I want to know what the results of that factual information was.

MR. TARRING: It goes to his analysis and his intermediary conclusions in deciding what to do. What he did with the case, I think is quite clear.

MR. WELSH: I object on the grounds that it calls for his analysis.

MR. LYNCH: I do not want to know the analysis. What I want to know what facts he came away from that meeting with. I don't want to know anything about his conversation with Mr. Stewart. There is a notation on this file, that the examiner saw fit to put on there. This is a public document, and I am entitled to ask what that notation means, and what the results of that consultation means.

MR. TARRING: He's told you what the note says. That is what he felt appropriate to put on the file, and he's given you a full explanation of it.

MR. GOLDENBERG: It is not a full explanation of it, sir.

MR. TARRING: This is an interoffice consultation with regard to reaching his conclusions with respect to this application. I do not think that such consultations are open to this kind of discovery.

Q Who was Mr. Stewart?

Q I don't remember. I don't think -- it's too far back in the past to remember.

Q Was he a patent examiner?

A Yes.

Q Where it mentions a class in connection with his name, does that indicate the area in which he was examining patents, the art classification in <sup>which</sup> ~~which~~ he was examining patents?

A I don't know.

Q Are those Classes 179-15 in your art unit?

A No.

Q Now below that reference to Mr. Stewart that I asked you about, there is another reference, can you read that?

A Semi-colon Chapman and Shaw in Class 340 sub-class 172.5.

Q What was the nature of your discussions with Mr. Chapman and Mr. Shaw?

MR. TARRING: Again, I think we are in the same area. We might verify -- were Mr. Chapman and Mr. Shaw patent examiners?

THE WITNESS: Yes, they are patent examiners.

Q Did you consult with them about the action you



were going to take on this application, or did you consult with them about facts that existed in the prior art?

A: Facts with respect to the prior art.

Q Is that what you consulted with Mr. Stewart about as well?

A Yes.

Q What did you find factually with respect to the prior art?

MR. WELSH: I object to the question on the grounds that it inquires into the analysis of the examiner of the application and the art which he felt to be relevant to his searching to determine what his action would be acting upon the patent application, and that is exactly the type of inquiry that is restricted by the protective order in the Stafford, Sharrer Tool case. indicated that he made an inquiry of Mr. Stewart, and these MR. TARRING: I am not sure I am going to let him answer it. That was in the prior art with regard to Would you mind clarifying your question. I find it is extremely broad. all.

MR. LYNCH: He consulted with these people and listed it in the prior art. All I want to know is

what he found out, as a matter of fact.

MR. WELSH: That is calling for hearsay, and if it is not calling for hearsay, it is delving into the decision making process.

MR. TARRING: I am still perplexed as to what you are after. It obviously means something to you, but I am not sure this means anything to me.

MR. LYNCH: This has nothing to do with his decision making process prior art with respect to

MR. TARRING: I think it does.

A MR. LYNCH: I don't believe it does at all.

MR. TARRING: In the broad sense you are asking it does; you might narrow the context.

A MR. LYNCH: What narrower context are you talking about that you will permit the answer?

reference What I am trying to figure out, the examiner has indicated that he made an inquiry of Mr. Stewart, and these other gentlemen, in connection with multiplex and the fact that was in the prior art with regard to multiplex. I want to know what he found out from those inquiries, that's all.

MR. TARRING: Do you want to ask if he was to directed to any specific patents in those areas?

That would be specific.

MR. GOLDENBERG: Well, were you directed to --

man to MR. WELSH: I would like to inquire if Mr. Goldenberg is still examining.

MR. GOLDENBERG: I am defending my client; that is all I am doing, sir.

Q I want to know one thing; what did Mr. Stewart and the other two gentlemen point out to you about what existed in the prior art with respect to multiplex?

A Mr. Shaw and Mr. Chapman are not involved with multiplex.

Q What are they involved with?  
A Computers.

Q Did Mr. Stewart point out any specific references in the prior art?

A No.

Q Did Mr. Stewart tell you anything about the prior art that had to do with multiplex?

MR. WELSH: Object to the question.

MR. TARRING: You have gone too far.

MR. LYNCH: Mr. Tarring, the examiner went to the gentleman to ask about facts of what existed in

the prior art.

MR. TARRING: The examiner went to the gentleman to assist him in reaching his conclusion in doing his job.

MR. LYNCH: His testimony was that he went to them for facts about what existed in the prior art.

MR. TARRING: So?

MR. LYNCH: That is what I am trying to get.

MR. TARRING: Why don't you ask him if he found out any facts?

BY MR. LYNCH:

Q Did you find out any facts about what existed in the prior art with respect to multiplex from Mr. Stewart?

A No.

MR. LYNCH: That is the question I wanted to ask originally.

MR. TARRING: You asked what facts, you didn't ask yes or no.

MR. LYNCH: The answer can be none.

MR. TARRING: The question is what I have to go by. Bring it down to something I can handle.

Q Now, in all of the searches that you conducted

in connection with this application, do you recall if you found any art which was directed to a microprocessor operated pinball game?

MR. WELSH: Object to that question on the same grounds as before.

MR. TARRING: I have a great deal of difficulty with these broad questions. If you have a specific piece of art that he was aware of, that would be more specific.

MR. LYNCH: That, Mr. Tarring, is a very narrow question -- microprocessor operated pinball game.

MR. TARRING: It remains unfixed on any piece of prior art. I don't know. Are we going to do a lot of these kinds of questions. I can visualize people dreaming up new concepts to ask about.

MR. LYNCH: This is not a new concept. This is the only question in this regard that I intend to ask.

MR. TARRING: Of that nature?

MR. LYNCH: Yes.

MR. WELSH: I object to this question because it refers to searches which were part of the examining

process, and what he found which involved what he was looking for, and that involves his analysis. As worded, that question is improper.

Q I would like to know if you found, in connection with any of your searches, a prior art reference which referred to the microprocessor pinball game, to the extent you recall.

A May I make a request of counsel?

Q Yes.

MR. TARRING: Is there any other reference in here?

Q There is another reference of office action on 11-5-76 Popular Electronics ~~Altair 8800~~ Altair 8800, and another reference cited in the office action of 12-8-77 which is <sup>Kirschner</sup> Kuehner, and I have them if you would like to look at them.

A Not to an arcade base pinball game.

Q Not to an arcade base pinball game?

A I believe that was your question.

Q I said pinball this time.

A No.

MR. TARRING: If you have particular references that you have in mind, if you asked him what he is

1 aware of it might help.

105

2 MR. LYNCH: I understand that. If you were  
3 in my position, you would have asked the same question.  
4 Now, I am going to do it, we are not going to have  
5 that much problem with it.

6 Q Now, Mr. Hum, I want to show you an ad which  
7 appeared in the Electronics magazine dated March 21,  
8 1974 for Intel Corporation which I will ask the  
9 reporter to mark as Hum Deposition Exhibit No. 2.

10 (The document referred to was  
11 prior art. No. I will ask the reporter to mark as Hum  
12 marked Hum Dep. Exhibit No. 2  
13 for identification.)  
14 Deposition Exhibit No. 3 a number of pages reproduced

15 Mr. Hum, I call your attention in this ad to  
16 from Electronics magazine, October 23, 1973, special  
17 the text to the left of the two small red checks that  
18 I have placed, one on each page of Exhibit 2, and ask  
19 you to review that generally, and in particular the  
20 text opposite the red checks, and tell me if you were  
21 aware of that advertisement during the examination of  
22 the Nutting patent?

23 A No, I was not aware of this advertisement.

Q Were you aware of any reference that referred  
to the use of the Intel 4004 microprocessor to be  
used to control a pinball machine?



MR. WELSH: At what time?

Q During the examination of the Nutting patent application.

A Not during the examination of the Nutting patent application.

Q Have you become aware of such prior art since that time?

MR. TARRING: Such advertisement?

MR. LYNCH: No. Leave it where it is, such prior art. No. I will withdraw the question.

I will ask the reporter to mark as Humatrol Deposition Exhibit No. 3 a number of pages reproduced from Electronics magazine of October 25, 1973, Special Issue, the Great Takeover, pages 69 to 103 of Electronics magazine.

(The document referred to was marked Hum Dep. Exhibit No. 3 for identification.)

Q Mr. Hum, I ask you to look at Hum Deposition No. 3 and particularly the top line on the righthand column on the page that follows Page 97, which is apparently Page 98, and ask if you were aware of this article during the examination of the Nutting patent

application. By that, I mean during your examination of the Nutting application, and while the Nutting application was in your jurisdiction.

A No, I wasn't aware of this reference.

Q I particularly refer you to the paragraph "On the burgeoning list of small systems being given an extra degree of "intelligence" and sales appeal by microcomputers are computers for the small businessman, electronic cash registers for hamburger stands, transducers that double as process controllers, pinball machines, self-calibrating medical instruments, traffic controllers, and a host of data terminals."

Is it your testimony that you were not aware of that portion of the article?

A No, I wasn't aware of this article.

Q Were you ever made aware or were you aware of an electronic pinball machine designed by Bally? Were you made aware of any prior designs of electronically controlled pinball machines by Bally during the prosecution of the Nutting patent application?

MR. TARRING: Do you have anything specific to show what you are talking about?

MR. LYNCH: I would like to know if he was

aware, or was made aware of a design of electronically controlled pinball machine by the Bally Corporation.

MR. WELSH: I object to the question as lacking a foundation, and assuming a fact.

MR. LYNCH: Let me ask the report to mark this as Hum Deposition No. 4, an article from *Electronic Engineering* today, November, 1973, Pages 37, 38, 39 and 40.

(The document referred to was marked Hum Dep. Exhibit No. 4 for identification.)

Q Mr. Hum, were you aware of that article during the time that the Nutting patent application was within your jurisdiction in the Patent Office?

A No, I was not aware of this article.

Q Specifically, I would like to refer you, Mr.

Hum, to the bottom of the righthand column on Page 37 of Hum Deposition Exhibit 4 where it says the following: the following quote is ascribed to Mr. Ross Schier, who is marketing manager of the Chicago-based Bally Corporation: "We've designed an electronic flipper machine where we could use solid-state devices probably more in memory functions than anyplace else--but found

1 our costs were higher than if we used traditional  
2 methods and electromagnetic devices. We've gotten to  
3 be proficient in the way we're making machines now  
4 that we've decided not to venture into solid state."

5 During the prosecution of the Bally application,  
6 Mr. Hum, were you made aware of that fact that in 1973  
7 Bally had designed an electronic pinball game?

8 MR. WELSH: I object to the question as  
9 assuming a fact, stating a fact that has not been  
10 proven as a fact. There is no foundation for the  
11 question.

12 Q Were you made aware of either the fact that  
13 Bally had designed an electronic pinball game, or that  
14 it was reported that Bally had designed such a game?

15 MR. WELSH: Object to that question as being  
16 designed in the alternative, and therefore, indefinite,  
17 and also assuming the fact that Bally had been reported

18 MR. LYNCH: That, I will make an offer of  
19 proof on. I can prove that was published in 1973.  
20 Do you deny it?

21 MR. WELSH: I am not going to comment on that  
22 at this time.

23 MR. GOLDENBERG: You should after what you

1 just said.

110

2 MR. LYNCH: You are implying that I would put  
3 before the witness some type of article which might  
4 somehow be false.

5 Q Can you answer the question. Excluding  
6 them.

7 MR. WELSH: I am going to object. It assumes  
8 as a fact something that has not been proven.

9 Q Were you aware during the time that the Nutting  
10 patent was within your jurisdiction in the United  
11 States Patent Office that Bally had designed, or had  
12 been reported to have designed an electronic pinball  
13 machine?

14 MR. WELSH: It's the same question and the  
15 same objection. It's assuming a fact that Bally had  
16 designed such a game.

17 MR. TARRING: The one thing that bothers me  
18 about that question, what do you mean by electronic,  
19 or does that mean something to you?

20 THE WITNESS: Electronic doesn't bother me;  
21 what you mean by electronic might. Could I have the question read back?

22 (Question read back.)

23 MR. WELSH: I also object to this line of  
questioning to the extent that it might result in

1 violation of 35 USC 122.

2 MR. TARRING: Are your questions directed  
3 toward any other application that might be on file?

4 MR. LYNCH: No. Excluding any other  
5 applications that are on file, specifically excluding  
6 them.

7 A I think I would have to answer maybe.

8 Q What was the source of your information?

9 A A magazine article.

10 Q Do you know what magazine article that was?

11 A I don't remember.

12 Q Do you remember when you saw that magazine  
13 article? Yes, but I am not sure if it is there.

14 A That is why the maybe, I don't remember.

15 Q Do you remember in what publication this  
16 magazine article appeared?

17 A Not specifically.

18 Q Do you remember what the subject matter or  
19 what your recollection tells you was the subject  
20 matter of this magazine article in the context of an  
21 electronic pinball machine having been designed by  
22 Bally?

23 A I think at this juncture it would violate

Q Did this magazine article come to your attention after the Nutting patent application passed out of your jurisdiction?

A Maybe.

MR. WELSH: I thought the question was of the during his --

MR. LYNCH: Yes. He said maybe to both.

Q Is that article located in the shoes which you maintain in your search area?

A I believe so.

Q Do you know what sub-class it exists in?

A Yes, but I am not sure if it is there.

Q Where would it be, if it were there?

A Technically, it should be in Class 273 - 121A.

MR. LYNCH: I would like to have the reporter mark as Hum Deposition Exhibit No. 5 copy of an article appearing in Electronics, March 1, 1973 at Pages 63 and 64, entitled Microcomputers muscle in.

(The document referred to was marked Hum Dep. Exhibit No. 5 for identification.)

Q On Page 64 of Hum Deposition No. 5, concluding



1 sentence, ascribed to Mr. Kroeger the following: "My  
2 example of a mass market is pinball machines. I think  
3 I mean that literally but most people think I am  
4 exaggerating."

5 I ask you, Mr. Hum, if you were aware of  
6 Hum Deposition Exhibit 5 during the examination of the  
7 Nutting patent application and while it was within  
8 your jurisdiction?

9 A I don't think I was aware of that reference.

10 Q Mr. Hum, in the office action of February  
11 26, 1976, it says on Page 4, "If applicant includes  
12 in Claims 1 and 12 limitations directed to a pinball  
13 machine and associated elements, eg. player operated  
14 flipper means, ball means and projector means, et  
15 cetera, correlated to claimed structure, and if the  
16 indefinite portions are clarified, then claims would  
17 appear allowable.

18 At the time you issued that action, is it  
19 fair to say, Mr. Hum, that you were not aware of Hum  
20 Deposition Exhibits 2, 3, 4, and 5?

21 MR. TARRING: Hasn't he already testified  
22 in effect to that?

23 A Yes. MR. TARRING: I agree. Advise you not to

Q Now in the first office action, Mr. Hum, you rejected all of the claims of the application, isn't that correct?

MR. TARRING: Your position, Mr. Welsh, is that here we are going into interpreting the file.

MR. LYNCH: Mr. Tarring, just to make a readable file, it is easy for you to understand to set a precedent for the next question. I am really not belaboring the point.

MR. TARRING: I don't want to get into interpreting the file, we have a job to do. We started at 9:30 and it's after 4:00 already.

MR. LYNCH: ;I understand.

Q Mr. Hum, referring to the office action of February 26, 1976, is it not correct that you rejected all the claims of the Nutting patent application?

MR. LYNCH: I understand that. I am pointing out there is a court that says that is appropriate.

A Yes.

Q Now at the time were any of the claims limited to a pinball game?

MR. TARRING: I think that in certain items, if I am recalling the same case you are referring to, I think we do disagree with the breakdown as far as calling for an interpretation of the claims, and it is surely an improper question.

MR. WELSH: I object to the question as Mr. Hum, I would like to refer you to the

MR. TARRING: I agree. Advise you not to

1 answer that one.

115

2 to the MR. GOLDENBERG: I seriously doubt the plain-  
3 tiff will be taking that position at time of trial.

4 MR. LYNCH: Your position, Mr. Welsh, is that  
5 Mr. Hum cannot testify as to whether any of these  
6 claims are limited to pinball, is that your position?

7 MR. WELSH: I am objecting to the question  
8 calling for Mr. Hum to interpret the claims, calls  
9 for his mental process.

10 MR. LYNCH: I would like to point out there  
11 are cases where it is proper to ask an examiner on  
12 what he relied on issuing an office action, and what  
13 facts he relied on.

14 MR. TARRING: Cases in which the Patent and  
15 Trademark office was not a party.

16 MR. LYNCH: I understand that. I am pointing  
17 out there is a court that says that is appropriate.  
18 I gather you don't think it is appropriate.

19 MR. TARRING: I think that in certain items,  
20 if I am recalling the same case you are referring to,  
21 I think we do disagree with the breakdown as far as  
22 what due process is.

23 Q Mr. Hum, I would like to refer you to the

1 office action of November 18, 1976, and in particular,  
2 to the first paragraph on Page 2 of that office action,  
3 where it is indicated the notice of allowance or the  
4 indication of allowance was being withdrawn in view of  
5 references recently brought to the attention of the  
6 examiner. Yes.

7 Q How did the references that you cited, and on  
8 which this action is based, come to your attention?

9 A I had received it in the mail, I presume. ~~ling~~  
10 Which reference are you referring to? ~~examiner.~~

11 Q It says in view of references recently brought  
12 to the attention of the examiner. I was wondering  
13 what the circumstances were under which these of the  
14 references were brought to your attention? ~~amendment~~  
15 received MR. TARRING: Can you identify the references?

16 you Q (Continuing) What are the references to which  
17 you refer in the first paragraph of the office action  
18 of November 18, 1976? ~~action?~~

19 A I think that is a reference to Popular Elec-  
20 tronics. ~~t was thinking?~~

21 Q I believe that is in your 892, only a single  
22 new reference is noted.

23 Q How did that reference come to your attention?

A I received it in the mail. I am so far behind in my reading, it is just stacked up. Popular Electronics is a magazine I subscribe to.

Q And you were behind from January, 1975 to November of 1976?

A Yes.

Q What caused you to select that Popular Electronics article as being relevant?

MR. WELSH: Object to the question as calling for analysis of mental process of the examiner.

MR. TARRING: I advise him not to answer that one. I agree it calls for analysis of mental process.

Q I would like to refer you to Page 6 of the response to that office action, that is the amendment received or dated February 22, 1977, and ask you if you recall what the applicant was setting forth at that time as being the fundamental essence of the invention of the application?

MR. TARRING: Are you asking him what the applicant was thinking?

MR. LYNCH: No. I am asking what he was setting forth.

Q Let me ask you this, Mr. Hum: Do you recall

1 entering the <sup>prosecution</sup> ~~prosecution~~ of this case the applicant's  
2 intention about what the essence of the invention was?  
3 know what MR. WELSH: I object to that, also, as in-

4 quiring into his mental processes, analyses, or con-  
5 clusions, in acting upon the application.

6 MR. TARRING: I don't care if he doesn't  
7 have to go to the file to do it. If he recalls, he  
8 recalls.

9 the A: I don't recall.

10 app Q: Now with respect to the operation of seven  
11 segment displays, Mr. Hum, were you familiar during  
12 the time that you examined the Nutting patent appli-  
13 cation the manner in which seven segment displays  
14 were operated?

15 seven so MR. WELSH: Where?

16 operated In any context. Were you aware how they  
17 operated; were you aware of the operation of seven  
18 segment numerical displays?

19 MR. WELSH: Object to the question as lacking  
20 a foundation.

21 respect MR. LYNCH: Mr. Tarring, you are looking pained.  
22 If you want me to drag out a hundred and fifty refer-  
23 ences on seven segment displays and establish whether

1 or not the examiner was aware of each one, and then I  
2 still haven't established this one fact. I want to  
3 know whether or not he was aware of the manner of  
4 operation of seven segment numerical displays.

5 MR. TARRING: With respect to what? on the

6 grounds MR. LYNCH: With respect to any manner in  
7 which they are applicable.

8 Q Let me ask this question: Were you aware of  
9 the fact that in the prior art to the Nutting patent  
10 application that alphanumeric seven segment displays were  
11 operated by multiplex techniques? MR. WELSH: I object to the question as  
12 prior to MR. WELSH: I object to the question as  
13 assuming a fact which has not been proven.

14 Q Were you familiar whether or not alphanumeric  
15 seven segment displays in the prior art had been  
16 operated using multiflex techniques?

17 A May I consult with counsel? prior art

18 Q Yes.

19 MR. WELSH: I would like to object to the  
20 question as to what is meant by prior art, with  
21 respect to what?

22 MR. LYNCH: With respect to the Nutting patent.

23 A Would you repeat the question?



1 Q Will you tell me, Mr. Hum, whether you were  
2 aware that in the prior art of the Nutting patent  
3 application seven segment alphanumeric displays were  
4 operated using multiplex techniques?

5 general MR. WELSH: I object to the question on the  
6 grounds stated to the one next previous to the last  
7 question.

8 MR. TARRING: I don't like the use of prior  
9 art. You have a factual situation that exists and if  
10 you want to ask him if he was aware of whatever it is.

11 appQest Were you aware of published references dated  
12 prior to the filing date of the Nutting patent appli-  
13 cation, which talked about the use of multiplex  
14 techniques to seven segment alphanumeric displays?

15 mark as MR. WELSH: I object to this question. It  
16 assumes a fact. Rockwell International, specifically  
17 Page A6 I was not aware of any specific prior art  
18 reference. (The document referred to was

19 Q Were you aware generally that such techniques  
20 had been used to operate alphanumeric seven segment  
21 displays? I ask you, Mr. Hum, if you were aware  
22 appAcat I would have been reasonably certain that  
23 such did occur.

1 Q Let's talk about seven segment numeric  
2 displays, is your answer the same? direct you to Page

3 A What was the question? if you, at the

4 time? Q I was asking you whether you were aware, you  
5 generally seven segment numeric displays were operated  
6 using multiplex techniques in the prior art to the  
7 Nutting application, let's say?

8 Were you aware generally that techniques  
9 using multiplex were used to operate seven segment  
10 numeric displays, prior to the Nutting patent  
11 application? A I will ask the reporter to mark

12 this. A I am reasonably certain that I was aware of  
13 such techniques. (The document referred to was

14 Q I show you what I will ask the reporter to.  
15 mark as Hum Deposition Exhibit 6, Parallel Processing  
16 System (PPS), Rockwell International, specifically  
17 Page 6 of that document. Computer Set, Users Manual,  
18 dated March, 1972, marked (The document referred to was  
19 at the time that you were marked Hum Dep. Exhibit No. 6  
20 application? for identification.)

21 A I ask you, Mr. Hum, if you were aware of that  
22 application at the time you examined the Nutting  
23 patent application? There's been a lot of discussion

1 here A I was not aware of this publication.

2 I ha Q In particular, Mr. Hum, I direct you to Page  
3 6 of Hum Deposition No. 6, and ask if you, at the  
4 time you examined the Nutting patent application, you  
5 were familair with the drawings of computer systems  
6 such as or that type of schematic drawing as described  
7 there in the application notes?

8 MR. WELSH: I object to the question. He  
9 stated that he was not familiar with it at that time,  
10 and the question lacks foundation.

11 Trademar MR. LYNCH: I will ask the reporter to mark  
12 this next document: (The document referred to was  
13 can be noted in here and (The document referred to was  
14 present application, and marked Hum Dep. Exhibit No. 7  
15 MR. WELSH: for identification.)

16 any Q I will ask you, Mr. Hum, whether you were  
17 aware of the MCS-4 Micro Computer Set, Users Manual,  
18 dated March, 1972, marked Hum Deposition Exhibit 7,  
19 at the time that you were examining the Nutting patent  
20 application?

21 the A yes I was not aware of this at the time of the  
22 Nutting application. Q: No.

23 MR. LYNCH: There's been a lot of discussion.

1 here, Mr. Tarring, about another patent application.  
2 I have a copy of another patent application. It is  
3 still an application in the office, which I obtained,  
4 I might add, from a foreign source who submitted it.

5 ~~came in~~ Is the position of the Patent Office that I  
6 may not examine the examiner about the facts set forth  
7 in this? I have it in my possession. ~~it was sub-~~  
8 ~~mitted a~~ MR. WELSH: I will object. ~~it is available.~~

9 MR. TARRING: You may have it in your possession  
10 but 35 USC 122 is very specific against the Patent and  
11 Trademark Office.

12 MR. LYNCH: There are certain facts which  
13 can be noted in here which could be relevant to the  
14 present application, and I am wondering -- Patent  
15 Office. MR. WELSH: That is what we are objecting to,  
16 any pending application. ~~is the application from, who~~

17 ~~is the~~ MR. LYNCH: It seems to me there are relevant  
18 aspects to inquire into here that certain aspects of  
19 this application which are relevant to the Nutting  
20 patent here, but your position is that I may not ask  
21 the examiner about such knowledge? ~~per attorney.~~

22 MR. TARRING: No. ~~Pages 81 and 95~~

23 of an act MR. WELSH: I object to any question calling,

1 for any information to be given by the Patent Office  
2 with respect to this, even as to whether Mr. Hum has  
3 any knowledge of it or not.

4 can p... MR. LYNCH: I've got the document, and I  
5 came into its possession properly. My position is in-  
6 sofar as this document is concerned, it contains facts.  
7 It came from a foreign patent office. It was sub-  
8 mitted as a prior art document where it is available.

9 A MR. TARRING: If it contains facts, I don't  
10 see why it is necessary to ask the examiner about  
11 facts in the document.

12 A MR. WELSH: Whether this examiner has any  
13 information or any knowledge of this application is was  
14 improper information to be given out by the Patent Unit  
15 Office.)

16 MR. TARRING: Who is the application from, who  
17 is the attorney of record?

18 MR. LYNCH: It's a Bally application. article.

19 I marked MR. WELSH: I don't think you will find that  
20 to be true.

21 MR. LYNCH: Then it's another attorney.

22 Q I will show you, Mr. Hum, Pages 81 and 95  
23 of an article from Electronics magazine, July 11, 1974,

1 in particular the last paragraph on Page 95, "The  
2 microprocessor monitors the placement of the ball, when  
3 it is sent down the lane by a player (one to four  
4 can play at any one time), keeps tabs on the <sup>pins</sup> ~~pines~~,  
5 and metes out free games and credits.

6 I would like to ask Mr. Hum if he was aware of  
7 that article during the pendency of the Nutting patent  
8 application?

9 A No, I was not aware of this.

10 Q Have you ever been made aware of that document  
11 under any circumstances?

12 A I don't remember.

13 A With Mr. Katz? (The document referred to was

14 Q Yes. marked Hum Deposition Exhibit

15 A I believe we dis No. 8 for identification.)

16 Q MR. WELSH: I think the record ought to show  
17 it is not a complete article. It is the 433-4.

18 Q MR. LYNCH: No, it is not a complete article.  
19 I marked that page.

20 Q MR. LYNCH: I don't have any further questions.  
21 EXAMINATION IN BEHALF OF THE PLAINTIFF

22 BY MR. WELSH: This one, but I am not certain  
23 I have Q Mr. Hum, when you were asked about this

1 Hum Deposition Exhibit 7, you stated that you were not  
2 aware of it at the time of examining the Nutting patent  
3 application resulting in the patent that ensued.

4 During that same time, were you aware of any  
5 other Intel manuals?

6 A Not during the prosecution of the Nutting  
7 application, the best I can recall.

8 con Q Do you have any such manual in your possession?

9 A I do now.

10 recd Q Do you recall discussing such a manual in  
11 your possession with Mr. Katz?

12 test MR. LYNCH: Objection, leading.

13 A With Mr. Katz?

14 Q Yes.

15 into A I believe we discussed this manual.

16 appr Q The manual that you have in your possession?

17 A Yes. I am not certain it is the MCS-4.

18 in to Q Did you discuss any Intel manual?

19 Nat A Yes.

20 Q What Intel manual do you have in your  
21 possession?

22 ex A I believe it is this one, but I am not certain.  
23 I haven't looked at it.



1 Q But you do remember discussing with Mr. Katz  
2 your manual during the interview?

3 A Can you be more specific to the interview?

4 MR. LYNCH: I object to the question as being  
5 grossly leading.

6 Q Do you recall discussing an Intel manual with  
7 Mr. Katz at the last interview you had with him in  
8 connection with this application?

9 MR. LYNCH: I would like to comment for the  
10 record that such leading of the witness under these  
11 circumstances is unfair. The witness has already examined  
12 testified that he didn't remember on this issue.

13 MR. WELSH: I don't think that is true.

14 MR. TARRING: I really don't want to get  
15 into such questions. I think they would be more  
16 appropriate for the court.

17 Q Are you familiar, Mr. Hum, with the proceeding  
18 in the Patent Office held in February called the  
19 National Inventors Day Exhibition?

20 A Yes.

21 Q Did you have anything to do with that patent  
22 exhibition held on February 10th and 11th?

23 A Yes.

1 not Q What is National Inventors Day Exhibition, to  
2 to your knowledge?

3 A It is an exhibition to display the work of  
4 inventors.

5 in with MR. LYNCH: I would like to object to this  
6 line of questioning as clearly exceeding the scope of  
7 direct.

8 MR. WELSH: If you have any objection, I will  
9 make the witness my own witness for the purpose of this.

10 a few MR. GOLDENBERG: You weren't invited to do if  
11 that, sir. You were invited to attend and cross examine.  
12 You should get your own subpoena and set up your own  
13 deposition.

14 Q What did you have to do with the National  
15 Inventors Day Exhibition?

16 MR. LYNCH: This is going into a mental is  
17 was or was not process, and I will advise you right now -- it comes

18 MR. WELSH: I am asking for facts, what he did  
19 in on the

20 THE WITNESS: May I confer with counsel?  
21 while, of

22 MR. TARRING: I am hard pressed to see the  
23 it was relevance of this since it occurred after the patent  
24 issued.

25 MR. GOLDENBERG: I make that objection. I do  
26 patent.

not believe it is relevant or reasonably calculated to lead to discovery of admissible evidence. because it represents

MR. WELSH: With your objection on the record, this is an act that I believe the witness participated in with respect to the patent ensued, and while not related to the application specifically, I believe it is a proper subject matter for us to inquire into.

Day Exhib If it is necessary, we will come back with a subpoena, but I am trying to avoid that. I only have a few questions basically to have the witness identify this document that I have, copy of a document that I believe was prepared by him, and that is the extent of that I wish to go. I am not sure about the inclusion

of this MR. LYNCH: This has to do with a reflection, allegedly on the worth of the invention, because it was or was not included in this exhibit. If this is admissible and any testimony of this examiner comes in on the issue of whether the invention is "worth-while, or good, or excellent, or anything" because it was included in this exhibition, the Patent Office has opened the door for me to examine this gentleman about his entire thought process about the Nutting patent.

MR. GOLDENBERG: I join in that.

1 issued. MR. LYNCH: It is absolutely a mental process  
2 situation, otherwise it is gross hearsay, because it  
3 represents an unsworn statement of the witness including  
4 this thing in an exhibition as the reflection of the  
5 worth of the technology involved. It is hearsay.

6 MR. WELSH: If you will stipulate that the  
7 Fireball pinball machine at the National Inventors  
8 Day Exhibition amounted to a recognition of the high  
9 level of invention of that apparatus, then it won't  
10 be necessary to continue.

11 to testify MR. LYNCH: Could you rephrase that; maybe  
12 high level is the thing that is giving me trouble. If  
13 the examiner is permitted to testify about the inclusion  
14 of this as germane to the level of invention involved,  
15 you have opened the door, Mr. Tarring.

16 MR. WELSH: I don't expect to ask any ques-  
17 tions about his reasons for doing this. I am only  
18 seeking to inquire that he filled out this application  
19 for exhibition space.

20 to the MR. GOLDENBERG: I tell you this, sir, if  
21 he does that, I have the right to cross examine on  
22 this document and all aspects of this matter.

23 MR. LYNCH: This is after the patent is out to

1 issued, and not an <sup>examination</sup> ~~examination~~ function, and we have  
2 opened the door to his mental processes with respect  
3 to the entire matter.

4 MR. TARRING: I don't agree with that at all.  
5 I haven't seen the stupid thing.

6 if you MR. LYNCH: The entire idea that this examiner  
7 is permitted to testify at all about an application  
8 for exhibit space that is prepared by him after the  
9 patent issued as reflecting on the worth of that  
10 patent, you are permitting a patent office employee  
11 to testify about facts after a patent is issued, and  
12 the only context that could be relevant has to reflect  
13 to the alleged worth of that patent, or that application.

14 not appropriate MR. WELSH: Where does it say anything about  
15 the alleged worth of the exhibit?

16 our right MR. GOLDENBERG: That exhibit is offered to  
17 the public for some public relations purpose on the  
18 part of the Patent Office, and there is perhaps some  
19 kind of suggestion that these things are being shown  
20 to the public as being meritorious things and meritorious  
21 patents.

22 MR. WELSH: That is not my point at all.

23 MR. LYNCH: What is your point. You want to

1 stipulate this was at this exhibit, I will stipulate  
2 it was there, the Fireball pinball machine was there.  
3 You want to stipulate to that?

4 MR. WELSH: Sure, I would.

5 MR. LYNCH: I will withdraw the stipulation -  
6 if you want to prove it was there, that is fine, but  
7 if you want to prove anything about the patent examiner  
8 making a request or filling out an application for  
9 exhibits or passed on the subject matter of a device  
10 which is allegedly covered by 40932, which is the  
11 patent in suit. If he knew that device was in  
12 accordance with that patent, there is a whole raft  
13 of things we are going to have to go into, and it is  
14 not appropriate.

15 MR. GOLDENBERG: Do you recognize, Mr. Tarring,  
16 our right, if it comes, to inquire about this matter?

17 MR. TARRING: Sure. I see where that is the

18 MR. LYNCH: May I see the statement you read  
19 effect at this morning? Patent examiners are forbidden to express  
20 opinions in testimony or otherwise.

21 MR. TARRING: I haven't heard anything yet  
22 as to his expressing an opinion. After you all take it  
23 up with it.

MR. LYNCH: This is a document directed to

1 the patent after it issued. I don't believe he can  
2 comment on it after it issued. I believe it passed out  
3 of his jurisdiction, and he is constrained not to  
4 comment on that patent after it is issued.

5 MR. WELSH: You are construing an action,  
6 and that is merely argument.

7 MR. GOLDENBERG: We will have to ask the  
8 examiner why this one was selected when there are a  
9 number of patents issued during the course of a year.  
10 There are all kinds of questions, and there is no end  
11 to it. I am willing to ask the questions. I should  
12 be delighted, if the door is opened to Mr. Hum's  
13 reasoning processes, that is the effect of this, Mr.  
14 Tarring.

15 MR. WELSH: I don't think that is the effect  
16 of it at all.

17 MR. TARRING: I don't see where that is the  
18 effect at all. I don't see where there is an opinion  
19 expressed in this. It seems to be a form stating

20 things.

21 MR. GOLDENBERG: It is far more than that.

22 MR. TARRING: I would rather you all take it  
23 up with the judge.



1 upon the MR. WELSH: It would save a trip back if we  
2 could have this document identified by the witness as  
3 having been prepared by him. as a fact, then we have

4 to go in MR. GOLDENBERG: I cannot consent to his  
5 identifying that document unless I am given an oppor-  
6 tunity to examine the witness about it, and all its  
7 ramifications. enough to see in National Inventors Day,

8 in the MR. TARRING: I don't agree with that. The  
9 fact whether he prepared it, it's there.

10 MR. WELSH: Questions about his opinion may  
11 be improper. What do you think Mr. Welsh

12 wants to MR. GOLDENBERG: Wouldn't it be better if we  
13 accept your suggestion and submit the matter to our  
14 judge. al in this case, and offer this document as a

15 certifi MR. LYNCH: I am perfectly willing to do that.

16 this acc MR. WELSH: I don't see that it is a proper  
17 inquiry for our court. You're alleging it involved  
18 some improper conduct of the Patent Office. have no

19 relevan MR. GOLDENBERG: There is no suggestion of  
20 improper conduct. Mr. Lynch's statements were very clear.

21 to the MR. LYNCH: I am saying for the examiner to  
22 have done it is one thing. For it to be submitted in  
23 this litigation is improper. What it does, it reflects

1 upon the fact that this examiner selected this patent  
2 to go into the exhibit space. If that is permitted to  
3 be addressed and established as a fact, then we have  
4 to go into the whys and wherefores, otherwise the  
5 inference is going to be made that examiner Hum, out  
6 of all the patents issued, selected this one as being  
7 meritorious enough to be in National Inventors Day,  
8 in the opinion of examiner Hum as reflected by that  
9 act. MR. LYNCH: By the examiner is what he wants

10 to establish. MR. TARRING: I don't see any opinion stated.

11 MR. GOLDENBERG: What do you think Mr. Welsh  
12 wants this for. There isn't any doubt in my mind that  
13 he is going to go, at the time of trial, if there is  
14 a trial in this case, and offer this document as a  
15 certificate of merit for this invention, and refer to  
16 this act as a recognition by the Patent Office. Is  
17 there any doubt in your mind on that? answer question

18 regarding MR. LYNCH: Otherwise, it would have no  
19 relevance. MR. TARRING: At this time. I would rather

20 you get it. Let's have Mr. Welsh state the relevance here  
21 to the issues here.

22 MR. WELSH: I don't feel compelled, at this  
23 time, to state any relevance.

1        MR. LYNCH: I understand that.

2        MR. WELSH: It's a fact as to whether the  
3 patent was selected for the space at the National  
4 Inventors Day Exhibition, and what inferences may be  
5 drawn by that are merely argumentative. This is  
6 simply whether or not space was requested and granted,  
7 and actually filled with a particular machine. Those  
8 are simply facts.

9        MR. LYNCH: By the examiner is what he wants  
10 to establish, the examiner involved.

11       MR. TARRING: In view of the fact that you  
12 are objecting because it goes beyond the scope of  
13 direct, and I think it is clear that it does, I would  
14 just as soon duck the question and let the court de-  
15 cide what to do. I don't need any more problems.

16       MR. WELSH: Do I understand correctly then  
17 that you will not permit the witness to answer questions  
18 regarding the National Inventors Day Exhibition?

19       MR. TARRING: At this time. I would rather  
20 you get it straightened out with the court as to where  
21 you stand on it. I am firmly convinced, insofar as  
22 this matter right here is concerned, it has nothing  
23 to do with the examination or the scope of the

1 protective order. If it is going to go back to the  
2 application itself and how the examiner considered  
3 matters there, I think that is entirely inappropriate,  
4 and certainly doesn't open the door to that extent.

5 the ques MR. WELSH: I have no other questions.

6 it is in FURTHER EXAMINATION ON BEHALF OF WILLIAMS: I  
7 will ask BY MR. GOLDENBERG:

8 Q Do you recall any discussions with Mr. Katz  
9 about Intel publications or manuals?

10 A Not in the course of the Nutting application,  
11 as best I can recall.

12 re issue Q Was there a discussion at some later time  
13 with Mr. Katz after the Nutting patent issued?

14 to A With respect to your question, at a later time.

15 Q Was it in connection with the application to  
16 reissue the Nutting-Fredericksen patent? These  
17 are open proceedings, that is my question. It

18 didn't MR. WELSH: There is no procedure in the  
19 Patent Office for examination of an examiner under

20 oath in reissue proceedings. You are improperly taking  
21 advantage of the suit pendency in the court on the

22 original patent to make inquiry into matters where you  
23 would not otherwise have the right to make such

1 inquiry. I object to that question. did you have in  
2 mind wh- MR. GOLDENBERG: Can we have an answer, Mr.

3 Tarring? I think I have the particular manual in my

4 office. MR. TARRING: I think I know the answer to  
5 the question, and that is why I think to a degree sessi-  
6 it is inappropriate. I think I know the answer but I  
7 will ask Mr. Hum to verify it. or possession?

8 A I am going to let him answer it.

9 A Would you repeat the question, please?

10 Q Was the discussion with Mr. Katz about the  
11 Intel manual in connection with the application to  
12 reissue the Nutting-Fredericksen patent?

13 A I really don't know, but I think I would have  
14 to--re May I explain? as an area of concern.

15 MR. TARRING: Yes. examiners handle applications  
16 in a par I am going to invoke 35 USC 122. to get those

17 applicat MR. LYNCH: That's the explanation? It the  
18 didn't sound like any explanation I ever heard. lications

19 in a par MR. WELSH: I think it is very acceptable. on  
20 goi:Q on Do you have more than one Intel publication  
21 in your possession, in your files, sir? anyone really.

22 A I don't know. sent issued, have you had any

23 dis Q You had something specific in mind when you

1 answered Mr. Welsh's question; what did you have in  
2 mind when you gave him an affirmative answer?

3 A I think I have that particular manual in my  
4 office.

5 Q Do you recall when it came into your possession?

6 A Very recently.

7 Q How did it get in your possession?

8 A I have to invoke 35 USC 122. ~~Here there?~~

9 Q Did Mr. Katz give it to you?

10 MR. WELSH: Objection. He already said he  
11 was invoking 35 USC 122. I think it is improper to  
12 ask him anything further about it. ~~Here occurred~~  
13 since the MR. LYNCH: The communications are right in?

14 the area where there is an area of concern.

15 MR. TARRING: Our examiners handle applications  
16 in a particular area, and they are going to get those  
17 applications, and there is nothing unusual about the  
18 fact that they might have one, two, or many applications  
19 in a particular area. I am not sure a communication  
20 going on between them; they are learning of prior art  
21 on a continuous basis should surprise anyone really.

22 Q Since the patent issued, have you had any  
23 discussed with Mr. Katz or any other attorney

1 representing Bally in connection with the Nutting  
2 patent? I have read the deposition.

3 A Since it issued?

4 Q Yes.

5 A Yes.

6 Q With whom, sir?

7 A Mr. Katz, I believe.

8 Q How many such conversations were there?

9 A I don't remember the number.

10 Q More than one?

11 A Yes, I would say so.

12 Q Have any of those conversations occurred  
13 since the application was filed to reissue the patent?

14 A Before the reissue was filed?

15 Q Since the reissue was filed?

16 A I don't think so, but I can't be certain.

17 (Whereupon, at 5:40 p.m., the taking of the  
18 deposition was concluded.)  
19  
20  
21  
22  
23



I have read the foregoing 140 pages, which contain a correct transcript of the answers made by me to the questions therein recorded.

*George J. Horn*

Signed before me this 5th day of Sept. 1979.

*Marian E. Ford*  
Notary

My Commission Expires January 13, 1981

My Commission Expires January 13, 1981

September 11, 1979

To whom it may concern:

Errata sheet for  
Transcript of Deposition of  
Vance Y. Hum  
on July 24, 1979

In addition to the errors corrected by interlineation and my initials in the original transcript, I want to point out that one answer, while correctly transcribed, indicates a possible inaccuracy. I discovered the possible inaccuracy on checking documents in my office subsequent to the deposition.

Specifically, at page 126, line 22, I indicated a belief that I had the Intel Users Manual for MCS-4 Micro Computer Set, dated March, 1972, a copy of which is designated Hum Dep. Exhibit No. 7, in my possession. In fact, the Intel User Manuals I have in my possession are the MCS-80 and the 8080 models. I do not have the Users Guide for the MCS-4 in my possession.

*Vance Y. Hum*

Vance Y. Hum  
Primary Examiner

*Sept. 5, 1979*